

O R I G I N A L

FILED

DOCKETED

SEP 21 1979

SEP 18 1979

H. STUART CUNNINGHAM, CLERK

STENOGRAPHIC TRANSCRIPT

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

----- X
BALLY MANUFACTURING CO.

Plaintiff,

vs.

D. GOTTLIEB & CO.,
WILLIAM ELECTRONICS, INC.,
and

ROCKWELL INTERNATIONAL

Defendants.
----- X

Civil No. 78 C 2246

Deposition of:

VANCE Y. HUM

Arlington, Virginia
July 24, 1979

DEO REPORTING

4880 KENMORE AVENUE
ALEXANDRIA, VIRGINIA 22304

OFFICIAL REPORTERS
OF FELONY CASES FOR
ARLINGTON COUNTY CIRCUIT COURT
AND THE CIRCUIT COURT OF
THE CITY OF ALEXANDRIA

751-0013

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
Eastern Division

----- x
BALLY MANUFACTURING CO.

Plaintiff,

v. Civil No. 78 C 2246

D. GOTTLIEB & CO.,
WILLIAM ELECTRONICS, INC.

and

ROCKWELL INTERNATIONAL

Defendants.

----- x
Arlington, Virginia

Tuesday, July 24, 1979

Deposition of VANCE Y HUM, called for examination
by counsel for the defendants, pursuant to notice, at
the offices of Benoit, Smith & Laughlin, 2001 Jefferson
Davis Highway, Suite 501, Arlington, Virginia, before
Corrinne H. Myers, a notary public in and for the State
of Virginia, beginning at 9:45 p.m., when were present
on behalf of the respective parties:

FOR THE PLAINTIFF:

DONALD L. WELSH, Esq., Fitch, Even & Tabin,
135 South LaSalle Street,
Chicago, Illinois 60603

1 A. SIDNEY KATZ, Esq., Fitch, Even & Tabin
2 135 South LaSalle Street
3 Chicago, Illinois 60603

4 FOR DEFENDANT WILLIAMS ELECTRONICS INC.

5 MELVIN M. GOLDENBERG, Esq.,
6 McDougall, Hersh & Scott
7 135 S. LaSalle Street
8 Chicago, Illinois 60603

9 FOR DEFENDANT D. GOTTLIEB & COMPANY

10 WAYNE M. HARDING, Esq.,
11 Arnold, White & Durkee
12 2100 Transco Tower
13 Houston, Texas 77056

14 JOHN F. LYNCH, ESQ.
15 Arnold, White & Durkee
16 2100 Transco Tower

17 WILL ALSO PRESENT:

18 Hum GERSON E. MEYERS, Esq.
19 Dressler, Goldsmith, Clement, Gordon & Shore
20 Hum 1800 Prudential Plaza
21 Chicago, Illinois 60601

22 Hum No. 5
23 HENRY W. TARRING, II, Associate Solicitor,
United States Patent & Trademark Office

Hum No. 6

Hum No. 7

Hum No. 8

I N D E X

Associate Solicitor, U.S. Patent and Trademark Office, and I would EXAMINATION IN BEHALF OF:--

WITNESS PLAINTIFF DEFENDANT WILLIAMS
MR. WELSH MR. GOLDENBERG

Vance Hum 125 8, 137

DEFENDANT GOTTLIEB
Mr. Lynch

from patent examiners. 90

Since 1880, the Patent and Trademark Office
has had a policy of re EXHIBITS FOR IDENT

Williams No. 1 (Patent Office application), 8

Hum No. 2 (Intel- March 21, 1974) 105

Hum No. 3 (The Great Takeover) 106

Hum No. 4 (EE/Systems Nov., 1973) 108

Hum No. 5 (Electronics March 1, 1973) 112

Hum No. 6 (PPS) 121

Hum No. 7 (MCS-4) 122

Hum No. 8 (Electronics July 11, 1974) 125

policy demands that every employee of the Patent

and Trademark Office refuse to express to any

person any opinion or view as to the invalidity

of any United States Patent. The question of

validity or invalidity is exclusively a matter

P R O C E E D I N G S

MR. TARRING: I am Henry W. Tarring, II, Associate Solicitor, United States Patent and Trademark Office, and I would like to make a statement for the record before the deposition begins. The statement is provided to explain the position of the Patent and Trademark Office in regard to testimony sought from patent examiners.

Since 1880, the Patent and Trademark Office has had a policy of refusing to permit examiners to comment concerning their decisions to grant, or to refuse to grant, a patent. That policy is currently expressed in Section 1701 of the Manual of Patent Examining Procedure, which reads, in pertinent part, as follows:

Congress in 35 U.S.C. 282, has endowed every patent granted by the Patent and Trademark Office with a presumption of validity. Public policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion or view as to the invalidity of any United States Patent. The question of validity or invalidity is exclusively a matter

1 for the courts to determine. Each member of the
2 examining corps is cautioned to be especially
3 wary of any inquiry from any person outside the
4 Patent and Trademark Office (including any
5 employee of another government agency), the
6 answer to which might indicate that a particular
7 patent should not have been issued.

8 Section 1701.01 of the Manual further
9 provides that:

10 Inasmuch as public policy does not permit
11 examiners to decide, as judges in the Patent and
12 Trademark Office, questions upon which they have
13 been retained to give opinions as expert witnesses
14 in patent cases in the courts, every examiner who
15 shall testify as an expert in a patent case pending
16 in any court will be dismissed, unless he shall
17 have to ^{testify} ~~testified~~ involuntarily, upon compulsion
18 by competent judicial authority, and without
19 retainer or preparation, Shaffer Book Works v.

20 it further provides that:

21 Patent examiners are forbidden to testify as
22 patent experts or to express opinions, in testimony
23 or otherwise, as to the invalidity of any issued

1 patent. In the opinion of the Patent and

2 mark III. In the past when testimony of examiners was
3 sought by compulsory process, the Courts have recognized
4 the Office's concern that examiner testimony be re-
5 stricted to strictly factual matter, in re Mayewsky,
6 162 USPQ 86 (E.D.Va. 1969); Shaffer Tool Works V.
7 Joy Manufacturing Co., 167 USPQ 170 (S.D.Tex. 1972).
8 The protective order which issued in Shaffer Tool
9 Works v. Joy Manufacturing Co., stated: question
10 which exists "**** the scope of the oral depositions of
11 the patent examiners ^{is} hereby limited to matters
12 of fact and must not go into hypothetical or
13 so speculative areas or the bases, reasons, mental
14 processes, analyses or conclusions of the patent
15 examiners in acting upon the patent applications
16 the maturing into the patent (in suit)." 167 USPQ 171.
17 Whenever it has been challenged, the court's have, in
18 effect, found this protective order to define the proper
19 scope of examiner testimony. Shaffer Tool Works v.
20 Joy Manufacturing Co., further reported at 175 USPQ
21 613 (S.D.Tex. 1972). Monsanto Co., v. Dawson Chemical
22 Co., 176 USPQ 349 (E.D.Va 1972), Fischer & Porter Co.
23 v. Corning Glass Works, 181 USPQ 329 (E.D.Pa. 1974.)

after.

1 It is the position of the Patent and Trade-
2 mark Office that the scope of testimony that may be
3 properly had of a patent examiner and as demonstrated
4 by the above protective order is well established in
5 the law and should govern the scope of testimony that
6 may be had in this deposition.

7 Accordingly, I am here today representing the
8 United States Patent and Trademark Office, and I will
9 advise Examiner Hum, not to answer those questions
10 which exceed the permissible scope of testimony as
11 reflected by the previously quoted protective order.
12 I will be willing to assist counsel rephrase questions
13 so as to avoid the prohibited area where possible.
14 However, should an impasse be reached, it will be
15 necessary for counsel to establish the propriety of
16 the testimony sought in court before the examiner
17 will answer.

18 MR. LYNCH: Just for the record, and stated on
19 behalf of myself and my client, I understand the
20 position of the patent office. I do not accept, however,
21 that statement contained in this statement as to what
22 the law is as being a correct statement. I do hope
23 we will have no problem, but that is my view of the
matter.

Whereupon, are your duties as a primary examiner?

A. Duties are outlined in Section MPEP 1004.

VANCE HUM,

was called for examination by counsel for the defendants,
and having been first duly sworn, was examined and
testified as follows:

EXAMINATION IN BEHALF OF WILLIAMS ELECTRONICS

to report BY MR. GOLDENBERG:

Q. Would you state, for the record, your name,
as you ordinarily use it, and give your residence
address?

A. My name is Vance Y. Hum, and I reside at
3401 Bexhill Place, Kensington, Maryland.

Q. Are you employed, sir?

A. Yes, sir.

Q. By whom?

A. The United States Patent and Trademark Office.

Q. In what capacity?

A. As a patent examiner.

Q. How long have you been employed in that
capacity?

A. A little over seven years, I believe.

Q. Is your title patent examiner?

A. No. I am a primary examiner.

1 Q What are your duties as a primary examiner?

2 A Duties are stipulated in Section MPEP 1004.

3 Q I don't have that with me. Could you tell
4 me generally what they are?

5 A I have signatory authority. I sign all final
6 rejections, supervise people who may be assigned to me
7 to report cases. I decide matters pertaining to re-
8 issue. In effect, I have full signatory authority
9 to act, through the director, to act on behalf of the
10 office.

11 Q Approximately how many people or examiners
12 report to you at any one time? I realize this might vary.

13 A It varies from zero to two.

14 Q Anyone report to you at this time?

15 A No, although, I am acting in a technical
16 consultant capacity for other examiners.

17 Q Could you explain what you do as a technical
18 consultant for other examiners?

19 A I handle, shall we say, any case involving
20 electronics or electronics related cases, and I pro-
21 vide other examiners with technical information.

22 Q Is this consultation provided to examiners
23 who are within your own group, or elsewhere in the

1 Patent Office?

2 A Basically within my own group.

3 Q Is that an officially assigned duty that you
4 have, sir?

5 A Not I think you would have to categorize it as
6 unofficial.

7 MR. TARRING: Let me ask how much of this
8 questioning you will have? I really don't see where
9 all of this has much to do with the facts of the
10 application. I am not sure when it was handled by
11 Mr. Hum, but this is more relevant to what his present
12 duties are. While we are happy to provide a certain
13 amount of this kind of testimony to help the judge, I
14 would hope that we don't become deeply involved
15 in such testimony.

16 MR. GOLDENBERG: I don't think we will, and
17 indeed the purpose of it is to advise the judge as to
18 what a patent examiner is and what he does. I believe
19 we are practically at the end of this particular line
20 of inquiry, I assure you, sir.

21 Q How long have you been a primary examiner?

22 A All Almost a year.

23 Q What position did you hold before you became

1 a primary examiner?

2 A I was an assistant examiner.

3 Q What were your duties as an assistant examiner?

4 A I was empowered, I was granted ~~ex~~ partial
5 signatory authority, in which case I could sign all
6 actions prior to final action, except for certain
7 situations, I believe cases over five years and things
8 of that matter, spelled out again in MPEP Section 1000,
9 duties.

10 Q Both as a primary examiner and as an assistant
11 examiner, is it your responsibility to conduct searches
12 with respect to applications that are assigned to you,
13 and then act on those applications depending on the
14 results of the search?

15 A Yes, sir.

16 Q Would it be correct that your responsibility
17 is confined to a certain class of technology, or art,
18 in the Patent Office?

19 A No, sir.

20 Q Would you explain?

21 A I function as an electrical electronics
22 generalist in the art, and I handle all cases that
23 pertain or that have electronic or electrical subject

1 matter. It runs a scope of whatever the art is in the
2 class.

3 Q Could you tell me what art is classified
4 in the art?

5 A I handled the educational art, the amusement
6 art, earth working, exercisers, and mechanical pro-
7 jectors. I also have handled cases in the ~~b-medical~~ ^{biomedical}
8 area, typewriters, printing, advertising. It is on a
9 case by case basis.

10 Q How can we identify this art unit?

11 A Art unit 334.

12 Q What is the first position you held in the
13 Patent Office, was that assistant examiner?

14 A Yes, sir.

15 Q You assumed that position about seven years
16 ago?

17 A Yes, sir.

18 Q Could you tell me very briefly what your
19 education after high school was, sir?

20 A I hold a BSEE, and I have had post graduate
21 courses.

22 Q What insitution is your degree from?

23 A University of Maryland.

1 Q When did you receive that degree?

2 A 1971.

3 Q In the course of study for that degree, did you
4 have a speciality within the electrical engineering
5 field?

6 A I guess you would say digital electronics and
7 computers, but I took just about ^{every} ~~ever~~ undergraduate
8 course that they offered.

9 Q The postgraduate courses that you referred to,
10 what were they?

11 A I had training at Goddard Space Flight Center
12 on telemetry systems with Bendix Field Engineering
13 Digital Systems Engineering.

14 I am presently enrolled at GW University,
15 the adult education, I guess, night course, for a
16 computer memory course.

17 Q These courses that you had at Goddard Space
18 Flight Center and under Bendix, were you employees of
19 any of those companies?

20 A I was employed by Bendix Field Engineering.
21 We were prime contractors there.

22 Q Was that before you assumed your position in
23 the Patent Office?

1 A Yes.

2 Q That was between your graduation from the
3 University of Maryland and the assumption of your
4 position in the Patent Office?

5 A Yes.

6 Q Was that job about a year or so?

7 A About a year and a half, a little over a year.

8 Q Prior to giving your deposition today, did you
9 do anything to prepare for this deposition beyond
10 talking to Mr. Tarring in connection with it?

11 A I read over the application this morning,
12 the patent file, I mean.

13 Q Have you had any conversations with anyone
14 other than Mr. Tarring in connection with this deposition?

15 A No. GOLDENBERG: My

16 MR. GOLDENBERG: I gather you met Mr. Welsh
17 yesterday, Mr. Tarring. Are you willing to tell us
18 what conversation you had with the attorneys for Bally
19 in connection with this matter?

20 MR. TARRING: I have no objection. I think
21 the discussion centered upon our position as reflected
22 in that protective order, and what they thought might
23 be forthcoming at the deposition. Beyond that, I

1 don't think there are any other specifics that we
2 went into.

3 MR. GOLDENBERG: Would you tell me what they
4 thought might be forthcoming?

5 MR. TARRING: I don't know that I care to
6 characterize their statements.

7 MR. LYNCH: I would think these conversations
8 should be open. There certainly shouldn't be a situation
9 where a government lawyer undertakes to advise one side
10 of the litigation and refuses to tell the other side
11 what those conversations were.

12 MR. TARRING: I have no objection to rendering
13 advise. I think I have been contacted by your firm
14 with respect to what our position is.

15 MR. GOLDENBERG: My contact, sir, was simply
16 to arrange for the deposition; can you agree with that?

17 MR. TARRING: I think so. I frankly don't
18 really recall.

19 MR. GOLDENBERG: I did not speak with you
20 about what might be forthcoming at this deposition. I
21 think that is quite a different kind of thing, and I
22 do think we are entitled to know what a government
23 lawyer, what conversations, a government lawyer may have

1 had with the plaintiff's attorney in this case. I
2 think it is very critical.

3 MR. TARRING: Well, I think they were con-
4 cerned that there may be some difficulty in segregating
5 the present case from another case, or other cases,
6 which have not issued as patents, and I think that
7 was their principal concern.

8 MR. GOLDENBERG: Did they make any --

9 MR. LYNCH: I don't quite understand that;
10 segregating in what context?

11 MR. TARRING: In the sense of his recollection.

12 MR. LYNCH: You are talking about segregating
13 the case in issue from other cases of Bally that Mr.
14 Hum might also have been involved with; is that the
15 problem?

16 MR. TARRING: Yes, there is a --

17 MR. GOLDENBERG: Did they identify any such
18 case to you, sir?

19 MR. TARRING: Not especially. I think they
20 did mention a patent, but I don't recall it -- not
21 a patent, but an applicant's name.

22 MR. GOLDENBERG: Was it Brocker?

23 MR. WELSH: I would like to raise an objection

1 at this point, that any information with respect to
2 any patent application pending in the Patent Office,
3 and communications between counsel for the applicatn
4 and the Patent Office is secret. I might say further
5 that was the basis of our concern with respect to Mr.
6 Tarring in our conversations with him to inquire
7 really as to whether the inquiry here today would be
8 limited to the issued patent, and not be permitted to
9 extend to any other application which has not issued
10 as a patent, and which perhaps is under the statutory
11 cloak of secrecy.

12 MR. GOLDENBERG: Perhaps we can excuse Mr.
13 Hum until we have this matter resolved.

14 MR. LYNCH: It seems to me the rules of prac-
15 tice provide that communications with the Patent Office
16 shall be in writing, so that there is a public record
17 of that communication. Now insofar as the communications
18 were made with the Patent Office orally, and they are
19 not in writing, I don't believe such communications
20 enjoy any such privilege of secrecy.

21 It is improper for counsel to communicate
22 with the Patent Office not in writing, and it is, there-
23 fore, not under the ambit of protection since that
communication can become lost. And if it is a

1 communication in connection with any pending application,
2 whether the one of primary concern today or another
3 patent application of Bally relating to a similar field,
4 I would like to say if that statement is not in writing,
5 it does not enjoy any protection or any guardianship
6 of secrecy. That is my position with respect to those
7 matters.

8 I think the Solicitor's Office would be con-
9 strained to agree that such communications have to be
10 in writing.

11 MR. TARRING: I really don't want to get into
12 this argument, and I don't know in the abstract what
13 you are referring to. We have to look at it on a case
14 by case basis.

15 MR. LYNCH: The rules so specify.

16 MR. WELSH: I might say that even written
17 communications are secret until and unless a patent
18 issues.

19 MR. GOLDENBERG: I would add, also, the
20 plaintiffs by seeking out the Solicitor's Office,
21 and Mr. Tarring, to discuss this deposition, it seems
22 to me very certainly waived any claim of secrecy that
23 they might have with respect to any matter discussed

1 with Mr. Tarring. We are concerned with this deposition,
2 and this lawsuit. And if the whole purpose of seeing
3 Mr. Tarring was in connection with this deposition and
4 this lawsuit, I think we are entitled to know, Mr.
5 Welsh, the entire conversation.

6 MR. WELSH: Mr. Tarring has summarized it.

7 MR. GOLDENBERG: If you have chosen, in a
8 conversation in connection with this lawsuit, to bring
9 in some other application assigned to Bally, it seems
10 to be that you waived any claim to secrecy in connection
11 with the matters discussed, at the very least; if not
12 the entire application.

13 MR. WELSH: I disagree strenuously with you
14 regarding that. I inquired into the scope of the
15 examination permitted by the Patent Office Solicitor's
16 Office.

17 MR. GOLDENBERG: Mr. Tarring, I ask this: I
18 assume the plaintiff's attorneys you were talking about
19 were Mr. Welsh and Mr. Katz, is that correct?

20 MR. TARRING: Correct.

21 MR. GOLDENBERG: Did they make any suggestions
22 or proposals to you how the scope of this deposition
23 could be limited?

1 MR.. TARRING: None.

2 MR.. GOLDENBERG: Did you make any proposals
3 or suggestions to them?

4 MR.. TARRING: I suggested to them that if
5 they recognize a question as being directed more to
6 something that might have occurred in another applic-
7 tion that has not issued as a patent, they let us
8 know about it, because I am not sure I would recognize
9 the situation. That is about the extent of it.

10 MR. WELSH: As long as we are speaking about
11 propriety, I would like to say that it would surely be
12 improper to use this proceeding to seek information
13 in regard to a pending application that is not
14 otherwise available.

15 MR. GOLDENBERG: I believe we have the right
16 to go into all matters which are in the interests of
17 our respective clients and arise out of the events
18 which caused this lawsuit.

19 BY MR. GOLDENBERG:

20 Q I show you a copy of United States Patent
4093232
21 4094342, which has previously been marked in proceedings
22 in this case as Deposition Exhibit WD 17, and I ask
23 you, sir, if you have ever seen that patent before?

1 A Yes, sir.

2 Q Were you the patent examiner who was
3 responsible for the application for that patent?

4 A Yes, sir.

5 Q Does that mean you examined it in the Patent
6 Office parlance, and I am putting examined in quotes?

7 A Yes.

8 A Were you the only examiner who had any
9 responsibility in connection with that application?

10 A Other than the signing, I wasn't assistant
11 examiner at that time; on the merits, yes.

12 Q You said other than the signing, does that
13 mean, sir, in connection with any paper that was
14 mailed out representing a Patent Office action, you
15 had to obtain somebody else's signature?

16 A My supervisor.

17 Q Who was that, sir?

18 A Mr. Richard C. Pinkham.

19 Q Was he your supervisor during the entire
20 period that the patent was pending?

21 A Yes, I believe so.

22 Q Is he still your supervisor?

23 A Yes.

1 Q Have you ever had occasion to read the patent
2 in the form in which it issued?

3 A Not totally.

4 Q Part of it?

5 A Parts of it.

6 Q What role was played by Mr. Pinkham in the
7 process of examining the application for the patent?

8 A I guess you might categorize his function
9 as strictly adviser.

10 Q Would it be correct, sir, when the application
11 was first filed and taken up for examination, that you
12 made the prior art search that was carried out by the
13 Patent Office?

14 A Yes.

15 Q Mr. Pinkham did not participate in that search?

16 A No.

17 Q With the results of that search in hand, you
18 prepared the first Patent Office action on the
19 application, is that correct?

20 A Yes.

21 Q Was it reviewed with Mr. Pinkham before it
22 was transmitted to the applicant?

23 A I don't remember.

Q Do you remember what your practice was, at that time, and if it might help you, I have here a certified copy of the file record of contents which has been marked in the litigation as Deposition Exhibit WD 18. It appears the first office action was mailed by the Patent Office in February 26, 1976. My question would be, having that date in mind, what was your usual practice with respect to consulting with Mr. Pinkham in connection with the action that you were taking on applications?

A Depending on the issues, I would not have to report case to Mr. Pinkham prior to signature. In any event, he would be responsible for signing the action.

Q In February of 1976 or about that period of time, what kinds of issues would you be required to consult with Mr. Pinkham about?

A May I confer with counsel a moment?

A Sure.

(The witness and Mr. Tarring conferred.

A Basically, it was on my judgment whether or not I needed some suggestions, or case law, whatever from Mr. Pinkham.

Q If you were doing nothing more in an application

1 than making a search, and then proposing to reject the
2 application, as you did here under 35 U.S.C Section 112
3 and 103, is that the kind of matter that you would
4 consult with Mr. Pinkham about?

5 MR. WELSH: I object to this question as hypo-
6 thetical.

7 MR. GOLDENBERG: I am trying to get the wit-
8 nesses experiences and practices at a specific point in
9 time.

10 MR. TARRING: I agree it is a hypothetical
11 question. We allow a certain degree of general practice
12 questioning. I don't think we allow what an examiner's
13 experience is when it is described as to be specific
14 to one or two cases. I think that is a general question
15 and I see no problem with his responding to it.

16 THE WITNESS: Would you rephrase the question,
17 please?

18 Q Do you want me to rephrase it or would you
19 rather have the question read back?

20 A Just have it read back.

21 (Question read back.)

22 A Maybe.

23 Q You have no recollection, one way or the other,

1 as to whether you consulted with Mr. Pinkham in
2 connection with this first office action on the appli-
3 cation for the patent, which is Deposition Exhibit WD 18?

4 MR. WELSH: I object to the question as
5 leading, and this witness hasn't testified at all with
6 respect to what he did in this particular case.

7 MR. TARRING: I would advise the examiner
8 he can answer that yes, no, or he doesn't remember.

9 THE WITNESS: Would you repeat that question,
10 please?

11 BY MR. GOLDENBERG:

12 Q Let me rephrase it.

13 Do you have any recollection, one way or the
14 other, with respect to the first office action in the
15 application here which action was mailed on February 26,
16 1976, as to whether or not you consulted with Mr.
17 Pinkham?

18 A No.

19 Q Do you have any recollection at all in
20 connection with this application, Exhibit WD 18, as
21 to whether you consulted with Mr. Pinkham at any time?

22 MR. LYNCH: I take it Mr. Tarring, you have
23 the file history here?

1 MR. TARRING: Correct.

2 MR. LYNCH: Is that available for us to look
3 at at sometime or other during these proceedings?

4 MR. TARRING: As long as it doesn't leave
5 my custody.

6 MR. LYNCH: I understand. I was going to
7 comment, if you were going to show that to the examiner,
8 which you haven't done yet, it is our general practice
9 to bring along the file wrapper to the deposition. It
10 is a Patent Office file record and must remain in the
11 custody of the Patent Office, and not leave our custody.
12 However, in many cases, it is more convenient for the
13 examiner to work out of the official file, rather
14 than work out of a certified copy with which is in-
15 experienced occurrence, or thing, or

16 MR. LYNCH: That's what I was getting at.
17 Whether we can do it that way, and whether that is
18 done. I was going to ask whether the examiner could
19 refer to the official Patent Office copy.

20 MR. TARRING: Yes.

21 MR. GOLDENBERG: In this connection, could
22 that be made available to Mr. Hum at this point in time?

23 MR. TARRING: Sure.

1 MR. GOLDENBERG: I believe the record should
2 now show that Mr. Tarring has placed in front of Mr.
3 Hum the official record of the Patent Office in
4 connection with this application for the patent.

5 BY MR. GOLDENBERG:

6 Q Mr. Hum, when you picked up the application
7 for the patent that ensued to act on it, what was the
8 first thing you did, sir?

9 A I read the case.

10 Q Do you have any specific recollections about
11 what you did in connection with the examination of the
12 patent that ensued? physical facts,

13 A I am not sure I understand.

14 Q Do you have any recollection of any kind of
15 event, or occurrence, or thing, or action that you took
16 in connection with the examination of the application
17 that ensued?

18 MR. WELSH: ARE you speaking of the entire
19 time of the examination?

20 Q I am speaking of the entire period from the
21 time that you began to examine this application until
22 the last action you took, and I think if you will look
23 at the file history in front of you, you will find

1 that period extended, apparently from sometime in
2 early 1976 to 1978.

3 MR. TARRING: You can answer that with a
4 yes or no.

5 A I think I would have to answer that maybe.

6 Q Could you tell me the recollection or recollec-
7 tions that you have in connection with the examination
8 process over that period of time?

9 MR. TARRING: At this point, the question is
10 broad enough that you could be going into the thinking
11 with the case, unless he understand that you are
12 referring only to the physical facts, if he searched
13 it, where he searched it, and those kinds of features.
14 I wish you would limit your question to the physical
15 facts of what happened without going into the mental
16 process.

17 MR. WELSH: I object also to the question as
18 calling for a narrative and recollection over a long
19 period of time. I think the question is indefinite in
20 that regard, too.

21 MR. GOLDENBERG: I do not believe I am calling
22 for a narrative, and I think your comments are well
23 taken. Indeed, sir, what I am inquiring about are

1 specific events or facts, not your thinking or what
2 was in your mind at that time. Do you understand that,
3 sir?

4 THE WITNESS: Yes.

5 BY MR. GOLDENBERG:

6 Q I would ask you to recite those events, those
7 facts that you recall in connection with the examination
8 process for this application.

9 MR. GOLDENBERG: Is that satisfactory?

10 MR. TARRING: I think that is satisfactory. I
11 am a little perplexed frankly, because his answer to
12 the previous question was maybe. I don't know what
13 the source of the maybe is, whether he recalls anything
14 really.

15 Q Do you recall anything?

16 MR. WELSH: I continue my objection as to the
17 indefiniteness of the question, because it does not
18 permit Mr. Tarring to determine on a question by
19 question basis whether the fact is being called for or
20 some mental process is being called for. I think the
21 question is too general in that regard.

22 MR. LYNCH: I think Mr. Tarring should be
23 allowed to fend for himself.

1 MR. TARRING: Could I suggest you ask him the
2 basis for the maybe, whether he recalls anything or
3 what the basis for the maybe is.

4 BY MR. GOLDENBERG:

5 Q Let's do that, Mr. Hum. You understand I
6 want your best recollection and do not want you to
7 speculate, but what is the basis for your answer maybe
8 in response to that question a few moments ago?

9 A As I referred to earlier in the deposition, I
10 am an electrical generalist, and I handle a number of
11 cases which relate to this art in particular. I am
12 not sure whether or not some of the events may have been,
13 with respect to these other applications, or with
14 respect to this one, in this case I think I would have
15 to answer I don't remember in those instances. If you
16 could direct the questions to specific events, I
17 could possibly answer the question.

18 Q Specifically, do you recall any interviews that
19 you had with one or more attorneys prosecuting the
20 application for the Patent Office?

21 A Vaguely, yes.

22 Q Could you give me the extent of that
23 recollection, sir?

1 A May I consult with counsel for a moment?

2 Q Yes.

3 (Whereupon, the witness and Mr. Tarring conferred.)

4 A In some of the interviews, I can recollect
5 bits and pieces; others, I can't, without going into
6 the file.

7 Q Let me direct your attention to Amendment C
8 filed on October 19, 1977. I cannot identify the
9 paper number.

10 MR. TARRING: What was the date?

11 MR. GOLDENBERG: Amendment C was filed on
12 October 19, 1977.

13 MR. TARRING: We have an amendment C that was
14 filed on February 22, 1977.

15 MR. GOLDENBERG: I am sorry. This is labelled
16 Amendment C, and perhaps it is really Amendment D. I
17 guess there was a cross of documents in the mail or
18 something like that.

19 MR. TARRING: We have located a paper that was
20 filed on October 19, 1977, right ahead of Amendment C
21 and marked in ink on the righthand corner as 11/D.

22 MR. GOLDENBERG: Does that mean paper number 11
23 and, in fact, it was amendment D?

1 MR. TARRING THAT would be my interpretation.

2 Q Could you turn to Page 17 of that amendment?

3 MR. WELSH: Do I understand the purpose of
4 this is for him to refresh his recollection?

5 MR. GOLDENBERG: If you have an objection,
6 Mr. Welsh, please state it; otherwise, please don't
7 interfere with my deposition.

8 Q I direct your attention to the first paragraph
9 and the remarks at the bottom of the page, and I note
10 a reference to an interview of June 14, 1977, by the
11 undersigned attorney. The undersigned attorney in
12 that amendment is A. Sidney Katz.

13 Do you have any recollection of that inter-
14 view, sir? I believe that was the first interview
15 with an applicant's attorney appearing in the file.

16 A In part, yes.

17 Q Could you state what you recall about that
18 interview?

19 MR. WELSH: Now, that the witness has finished
20 looking at the document, is it proper that it be
21 removed so that he testifies from his own recollection,
22 rather than with respect to references to the document.
23 I object to the question first, if the document remains

1 in front of him.

2 MR. GOLDENBERG: I don't understand that
3 objection.

4 Q: Could I have your recollection, sir, about
5 that first interview with Mr. Katz?

6 A: We discussed in the inclusion of pinball
7 type limitations.

8 Q: Do you recall how long the interview lasted?

9 A: No, sir.

10 Q: You have no idea?

11 A: No.

12 Q: Is it likely that it lasted more than an hour?

13 A: I have no recollection.

14 Q: Could you elaborate on this discussion with
15 Mr. Katz about the inclusion of the pinball limitation
16 in the claims?

17 MR. WELSH: I object to the question as
18 calling for a narrative rather than being specific,
19 indefinite.

20 A: I am not sure whether or not I would be vocal-
21 izing opinions as to what occurred. I don't remember
22 the entire events. I just remember that I had mentioned
23 the inclusion of pinball limitations in the claim.

1 Q This is something you said to Mr. Katz?

2 A Yes.

3 MR. TARRING: Let me advise the examiner here
4 to the extent that things were said and what have you,
5 if they might encompass an opinion, it would be okay
6 to testify to them, if you remember. So far as dis-
7 cussion is concerned, back and forth, what was said,
8 that is okay to testify to as a fact. It is limited
9 by your recollection of the specific facts.

10 Q Mr. Hum, what I am inquiring about is what you
11 said to Mr. Katz, and what Mr. Katz said to you.

12 A Okay, I understand.

13 Do you have any recollection of that, sir?

14 A To some extent, yes.

15 Q Could you give me the extent of that
16 recollection?

17 A We discussed including in the claims, limi-
18 tations for example of flippers, a moving ball, and
19 the like. I believe I referred to prior actions. Mr.
20 Katz indicated that the claims, that he wanted to
21 include more than just the pinball, the horizontal
22 type pinball field.

23 Q Did he tell you what other kind of game he

1 wanted to include?

2 A I don't think we identified it specifically,
3 but substantially vertical type projectile games.

4 Q Target games?

5 A I don't know if it would be proper -- let
6 me consult with counsel for a second.

7 (The witness and Mr. Tarring consulted.)

8 Q Please continue.

9 A We discussed the possibility of substantially
10 vertical playfields with a surface projectile.

11 Q With a surface projectile. Was any particular
12 game identified?

13 A No.

14 Q Was this a game with a moving ball on it of
15 some kind?

16 A Yes.

17 Q Was it a game called Pachinko?

18 A We didn't discuss that term specifically. We
19 didn't use that term specifically.

20 Q From your understanding, was the game Pachinko?

21 MR. WELSH: Object to the question. Calls
22 for understanding.

23 MR. TARRING: I think this was the source of

1 our discussion off the record. Insofar as he has a
2 recollection of what he said and what have you, back
3 and forth, during the interview, of course he may
4 answer. Insofar as he might draw a mental impression,
5 I think it is getting into verbotin area.

6 MR. GOLDENBERG: I withdraw the question.

7 Q Do you recall specifically what Mr. Katz
8 said to you about other kinds of games he would like
9 to try to cover?

10 A No. This is it.

11 Q This vertical surface with some kind of pro-
12 jectile. Was that a ball, as he explained it to you?

13 A I don't remember if he explained it to me or
14 I explained it to him.

15 Q Was it a ball as you explained it to him?

16 A I believe it was.

17 Q How was the ball to be put into motion?

18 A We didn't discuss it.

19 Q Do you recall anything else that was discussed
20 at that interview with Mr. Katz?

21 A We discussed the inclusion of software, I
22 believe.

23 Q Can you tell me what that discussion was about?

1 MR. WELSH: Object to that question. It
2 calls for him to characterize the conversation.

3 MR. GOLDENBERG: I withdraw the question.

4 Q Would you tell me the substance of that
5 discussion?

6 MR. WELSH: Same objection.

7 MR. TARRING: I think Mr. Hum knows the
8 limitations on what he can say now. I will be a little
9 bit liberal as far as the questions are concerned.

10 Q Mr. Hum, when I say that, what I am inquiring
11 about what you said to Mr. Katz and what Mr. Katz said
12 to you, I do not expect you to recall the precise
13 words; that is why I used the word substance.

14 A With respect to the 112 Paragraph 1 issue, I
15 wanted the software made available for examination.
16 Q You told that to Mr. Katz?

17 a Yes.

18 Q What did he respond?

19 A I don't remember.

20 Q Do you recall whether or not a resolution was
21 reached with respect to that matter?

22 A Yes.

23 Q Do you recall what that resolution was?

1 A Yes.

2 Q Could you tell me?

3 A Upon re-examination of the file after the
4 interview -- of the mental process or impression.

5 MR. TARRING: I am not sure, is this --

6 Q My question at this point was a resolution
7 at the time of that meeting.

8 A No. Your answer.

9 Q No resolution, agreed to --

10 A No.

11 Q I gather, sir, there was a resolution reached
12 with respect to that matter later in time?

13 A Yes, I remember.

14 Q Was there any agreement between you and Mr.
15 Katz as to how the claims would be amended to bring
16 in the pinball limitations that you were seeking?

17 MR. WELSH: Object to the question as calling
18 for his opinion as to agreement. No objection if there
19 is an inquiry as to what was said between the examiner
20 and Mr. Katz, but that calls for his mental processes.

21 MR. GOLDENBERG: I think as to whether there
22 was an agreement between the examiner and interviewing
23 attorney as to what course of action would be taken, or

1 if any action would be taken is a factual question and
2 nothing more.

3 MR. TARRING: While it might call, in the
4 broad aspect of his mental process or impression, I
5 think that it is probably a fair question to get at
6 what transpired at the interview. I think the examiner
7 is pretty well aware of the limitation. I see no
8 problem with your answering that.

9 A We tentatively agreed to the language a moving
10 mass.

11 Q Do you recall who suggested that language,
12 whether or not your recollection is refresh-
13 sir, was it you or Mr. Katz?

13 A I don't remember.

14 Q Did Mr. Katz make any arguments or statements
15 to you as to why that language should be used?

16 A I don't remember.

17 Q Was there any discussion of the prior art at
18 the time of that interview?

19 A I really don't remember.

20 Q Do you have any remembrance of that meeting,
21 other than that which you testified about?

22 A I think I would have to answer I don't re-
23 member.

1 Q Was Mr. Katz alone at the time of this inter-
2 view or was he accompanied by anybody?

3 A He was alone.

4 Q What I would ask you to do is to review the
5 remarks starting at Page 17, and see if -- and it is
6 about three and a half pages -- see if that refreshes
7 your recollection to any degree about what happened
8 at that interview. Could you do that?

9 Would you review or read the remarks of the
10 amendment in front of you, or any other part of the
11 amendment that you care to look at, and then tell me
12 whether or not your recollection is refreshed about
13 what was said or done at that meeting?

14 A Yes.

15 Q After reviewing this document in front of
16 you, sir, has your recollection been refreshed to any
17 degree as to what was said or done at that interview?

18 A Yes.

19 Q Could you tell me what you now remember?

20 A Yes, apparently a paper or an action had been
21 sent out on the merits, and I declined to discuss
22 those matters with respect to the prior art during that
23 interview until after he had received the action.

1 Q So you now recall there was no discussion of
2 the prior art at the time of that interview?

3 A Not to my recollection.

4 Q Do you have any recollection of the telephone
5 conversation referred to in the remarks accompanying
6 this amendment that you have in front of you at this
7 time, and I direct your attention to the paragraph
8 beginning at the bottom of Page 18?

9 A Yes.

10 Q Could you give me your recollection, sir, as
11 to what you said to Mr. Katz and what Mr. Katz said to
12 you in the course of the telephone interview that is
13 referred to there?

14 A I believe Mr. Katz indicated to me that the
15 software had been filed with the original specifications.
16 As evidence, I believe he pointed out a particular
17 paper in substantiation of that fact, and I took the
18 case under advisement.

19 Q After taking the case under advisement, what
20 did you do then?

21 MR. TARRING: I advise the examiner here you
22 don't get into mental processes.

23 Q I am talking about actions or communications

1 with the applicant.

2 A I don't believe I communicated with the
3 applicant. I do believe I discussed the matter with
4 Mr. Pinkham. I had resolved in my mind --

5 MR. TARRING: Wait a minute. I don't think
6 you want to get into the conclusions you reached in
7 your mind.

8 Q You believe you discussed the matter with Mr.
9 Pinkham?

10 A Yes.

11 Q Could you tell me the substance of that
12 discussion, sir?

13 ^{TARRING}
14 MR. ~~TARRING~~: Here, insofar as communications
15 between examiners within the office, it is our view
16 that is part of the decision making process. I would
17 cite the grandfather case in this area, United States
18 versus Morgan, a Supreme Court decision on which most
19 of the examiner testimony restrictions flow. That
20 appears to be the specific type of situation the
21 Supreme Court contemplated in that case, between
22 people in the decision making agency, if you will. I
23 don't think it is appropriate to get into discussions
between examiners, if you will.

1 MR. GOLDENBERG: I take it you would advise
2 the witness not to answer.

3 MR. TARRING: Yes, advise him not to answer.

4 BY MR. GOLDENBERG:

5 Q I direct your attention to the paragraph
6 beginning at the top of Page 19 of the Amendment, and
7 particularly the sentence starting in the second line,
8 continuing to the end of that paragraph.

9 Upon reading that, sir, does that refresh
10 your recollection to any degree as to what you did in
11 connection with the matter after taking it under
12 advisement?

13 A Yes, to some extent, but it involved opinion
14 to some extent.

15 Q What you did would involve opinion?

16 A In terms of the decision made on this issue
17 to some extent, yes.

18 Q Perhaps my question was not clear, but I note
19 in that sentence that I referred to is an indication
20 that the examiner, and I take it you were the examiner,
21 called the undersigned attorney. Did you do that, sir?

22 A Yes, I did.

23 Q What did you say to the undersigned attorney

1 who, I believe, to be Mr. Katz?

2 A I mentioned the fact that apparently the
3 software had been misfiled, or in any event, it wasn't
4 in the application for the previous rejection, but at
5 the time I talked to Mr. Katz, the paper was in the
6 file and that I -- may I speak with counsel for a
7 second?

8 Q Yes, please.

9 A During the telephone interview, I indicated
10 to Mr. Katz that I thought that the software was in
11 the case initially, but during prosecution had been
12 somehow mislaid. At the time of this interview was
13 back in the file, and that I considered a rejection
14 under 112, Paragraph 1 to be in error and that I
15 would withdraw it.

16 Q What led you to think that the software was
17 in the application originally, sir?

18 MR. WELSH: I object to that question as
19 clearly calling for his mental impressions. It is
20 asking what he thought.

21 MR. TARRING: It is going to his mental
22 process, but it is not going to his decision making
23 process, so viewing it that way, as long as we can keep

1 the decision making process out of it, if that is
2 possible, it will be okay to answer it.

3 Do you understand?

4 THE WITNESS: Yes.

5 A I am not certain whether or not I can segre-
6 gate the decision making process.

7 Q What facts led you to believe that it was
8 in the file originally?

9 A As pointed out by applicant's counsel with
10 respect to particular paper, apparently the transmittal
11 papers on filing of the application.

12 Q What transmittal paper do you have reference
13 to?

14 MR. TARRING: Could I identify it as a paper
15 that is dated May 12, 1975 and Form PO 1082 or 1062,
16 and apparently signed by Mr. Egr Sewall.

17 The first blank on the page indicates docket
18 number and the blank is filled in C-3987-1 dated
19 May 12, 1975.

20 Q What is it on that paper, sir?

21 A The box marked E logic sequence to be made
22 part of the file.

23 Q Was there anything else that led you to

1 believe that the software listing was or had in fact
2 been filed with the application?

3 A Possibly, but it would involve some of my
4 own impressions.

5 Q Where did you find the software listing
6 physically at the time you went to look for it after
7 this telephone conversation with Mr. Katz, and while
8 you were taking the matter under advisement?

9 A Inbetween some of the papers. I don't
10 remember where specifically.

11 Q But it was in the file wrapper?

12 A Yes, at the time of the interview, telephone
13 interview.

14 Q Was it bound in with the other papers?

15 A Yes.

16 Q Was there a patent office stamp on them, or
17 do you recall?

18 A I don't remember without looking.

19 Q With respect to the file that is in front of
20 you right now, could you show me where the software
21 listing is?

22 A I am not entirely certain, but I think this
23 is the copy.

1 Q At this time, it was not bound in the file,
2 was it, when you just pulled it out of there, it was
3 loose in the file?

4 A Yes, it was.

5 Q Do you have any explanation as to why it should
6 be loose in the file?

7 MR. WELSH: Object to this question.

8 MR. TARRING: I don't think he would be in a
9 position.

10 MR. GOLDENBERG: If he can't answer the question,
11 he can say so.

12 MR. WELSH: I think it is an improper question,
13 it gives a reason why. It gives his opinion as to
14 why something is there.

15 MR. GOLDENBERG: That question can be answered
16 with a very simple yes or no.

17 MR. TARRING: It's all right with me.

18 Q Could you answer it, sir?

19 MR. WELSH: I would like to make a further
20 objection to this question as lacking a foundation.

21 A May I consult with counsel?

22 A Surely. Can you sanwer the question, sir?

23 A No. I don't know the reason why it is out

1 of the file.

2 Q Mr. Hum, I have in my file, WD 18, which is
3 a certified copy of the file wrapper and contents,
4 a program listing which may or may not be identical
5 with what you have there. I believe it to be, but
6 it does include what I am going to call a cover sheet
7 bearing the caption Program Logic Array Unit Sequence
8 in Mnemonic Code. Can you find that sheet in the
9 file in front of you?

10 Would you agree that the sheet bearing that
11 designation that I read is in the file in front of you
12 and is actually fastened in the file, is that correct?

13 A Yes.

14 Q And that appears in the file following copy
15 of the letter of transmittal dated May 12, 1975, and
16 there appears to be two copies of that letter in the
17 file you have in front of you, is that correct?

18 A Yes, sir.

19 Q And they differ in that one has the dollar
20 value \$117, that's been circled and initialled by
21 somebody.

22 A Yes.

23 Q And that is the copy on the lefthand side
of the file, and the copy on the righthand side of the

1 file does not have that circle and initials, does it?

2 A No.

3 Q Do you have any explanation for this, sir, as
4 to why there should be two copies of that document in
5 the file?

6 MR. WELSH: I object to that question, and
7 this line of questioning. You have what appears to be
8 a certified copy of the file wrapper and contents as
9 of the date it was furnished to you, Mr. Goldenberg,
10 and obviously the file that was brought here by Mr.
11 Tarring this morning is in different condition. It
12 seems to me we are wasting time comparing the file
13 that you have that was certified to be a true copy
14 with the one that was brought here this morning.

15 MR. GOLDENBERG: I am not going to respond
16 to that. I believe I am entitled to inquire into these
17 matters.

18 MR. TARRING: I don't want the examiner to
19 become an interpreter of the file. If he has knowledge
20 of why, fine, but I have been advising him not to
21 guess.

22 MR. GOLDENBERG: I don't want him to guess.

23 MR. TARRING: If he knows why there's two there,

1 fina; if he doesn't, that is where it is going to have
2 to end.

3 MR. GOLDENBERG: I think that is correct.
4 I will withdraw the question.

5 Q Would it be correct, Mr. Hum, that the
6 factual events that led you to call Mr. Katz and say
7 that the Section 112 rejection would be withdrawn was
8 that you found the program listing in the file?

9 A In part, yes.

10 Q What other element was involved, sir, or
11 elements of fact? A It lacks any found

12 A The transmittal paper substantiated that
13 fact.

14 Q Anything else?

15 A Not that I remember.

16 MR. GOLDENBERG: I would like to have a few
17 minutes break and perhaps the witness would, also.

18 (Brief recess)

19 BY MR. GOLDENBERG:

20 Q Mr. Hum, with respect to the program listing,
21 was that a part of the application as filed?

22 MR. WELSH: Object to the question on the
23 grounds it calls for his opinion.

1 MR. TARRING: I think I agree with counsel it
2 calls for his opinion; to another extent, I think he's
3 indicated as much if you would care to ask him about
4 the statement.

5 MR. WELSH: It also lacks a foundation.

6 MR. GOLDENBERG: I have the patent, and I
7 cannot tell; that is the reason I asked the witness.

8 MR. TARRING: What specifically are you
9 asking. I have difficulty with the breadth of the
10 question.

11 MR. WELSH: It lacks any foundation that he
12 has any knowledge, also.

13 BY MR. GOLDENBERG:

14 Q Mr. Hum, as an examiner you act on and were
15 responsible for the examination of the application,
16 were you not?

17 A Yes.

18 Q Is it a part of your duties to read or
19 review the application as filed?

20 A Yes.

21 Q Did you do that in this case?

22 A Yes.

23 Q Do you recall at the time you read the

1 application did you read the program listing, and
2 this is the first time you read the application, sir.

3 A May I consult with counsel for a second?

4 Q Surely.

5 (The witness and Mr. Tarring consulted.)

6 A At the time of the examination, to the best
7 of my recollection, I recall the program listing.

8 Q I direct your attention to the office action,
9 which is Paper number 8 and bears on it mailed June
10 17, 1977. Specifically, I direct your attention to
11 Page 5 of this office action, and the paragraph of
12 that page with the second sentence -- let me read the
13 first and second sentence.

14 "Regret is expressed for the inclusion of
15 the new grounds of rejection and objection found in
16 35 USC 112 at such a late date. However, the software
17 for implementing the pending invention has just been
18 received."

19 Could you explain, sir, what that sentence
20 means or those two sentences mean?

21 MR. TARRING:- In a sense, I don't want him
22 explaining and expounding on the reasons which are
23 stated. Does this have relevance to --

1 MR. GOLDENBERG: I think it has relevance.

2 MR. TARRING: I am wondering what it has
3 relevance to, whether or not that was in the file as
4 originally presented, the so-called software listing.

5 MR. GOLDENBERG: That is the matter I am in-
6 quiring about, and I think you will agree with me that
7 the second sentence indicating that the software
8 for implementing the intended invention has just been
9 received raises what, I think, is a legitimate question
10 as to what is the fact of the matter. I think that
11 question is there.

12 MR. WELSH: If he recalls.

13 MR. GOLDENBERG: I am talking to Mr. Tarring.
14 My question is there because of later statements in
15 the file, and Mr. Hum's testimony in connection with
16 the matter. I would think there is perhaps an ex-
17 planation as to why there is, and I am going to use
18 the word conflict for the moment. By that, I mean
19 nothing pejorative at all. There is perhaps an
20 explanation that could be made. I am seeking that
21 explanation or reconciling of this apparent statement.

22 MR. WELSH: I object to the question as it
23 lacks a foundation if he has any recollection about
that. I object to the question as calling for a

1 reason for a statement that he made, rather than
2 calling for facts within his recollection.

3 MR. GOLDENBERG: My present question doesn't
4 at all go to reasoning. I am asking for an explanation
5 of the statement.

6 MR. WELSH: It is calling for his opinion now
7 as to the basis for the conflict, and I think it is
8 wholly improper. It is not based on recollection.

9 MR. GOLDENBERG: If there is any doubt on
10 that score, my question goes to at the time of the
11 statement, at the time the statement was made, not now.

12 MR. WELSH: Your question asked what does that
13 statement mean.

14 MR. TARRING: Insofar as there appears to be
15 perhaps a little bit of confusion on this point, I
16 think I will let ^{him} answer it. I want it understood,
17 however, I don't want the examiner being used to in-
18 terpret statements in the file wrapper. As a general
19 rule, it is inappropriate.

20 MR. GOLDENBERG: I appreciate your position
21 on that, sir.

22 Q If you can answer the question, I would
23 appreciate it.

1 MR. WELSH: Could we have the question
2 again. There has been a lot of colloquy.

3 MR. GOLDENBERG: I will restate the question.

4 BY MR. GOLDENBERG:

5 Q Do you recall now what you intended by that
6 statement which appears in the second sentence of the
7 last paragraph on Page 5 of the office action.

8 MR. TARRING: Could I suggest, instead of
9 asking what he intended, if you ask upon what facts
10 that statement was based or what the situation was at
11 that time when that statement got into the record, as
12 best he recalls?

13 Q I accept that, and if you could tell me, sir,
14 upon what facts did you rely when you made that
15 statement?

16 A Upon review of the preceding amendment, the
17 software listed, I was under the impression the soft-
18 ware listed was submitted with the preceding amendment,
19 but I had recalled the fact that I looked at the
20 listing before. I was apparently mistaken of where
21 or when the listing actually came in, and further
22 reference to the telephone interview that we had
23 discussed earlier.

1 Q This is the telephone interview with Mr.
2 Katz?

3 A Yes.

4 Q Is it the first or second one -- the one
5 where you called him back?

6 A Yes.

7 Q That was the second telephone interview?

8 A Yes. I explained to him at that point.

9 Q With respect to this software listing that you
10 say you had found in the file and called Mr. Katz,
11 how many pages did it have, sir?

12 A I don't remember the number of pages.

13 Q I have here a document which appears under
14 the seal of the Patent Office statement, this is to
15 certify that the annexed is a true copy from the
16 available microfilm records of this office of the
17 application as originally filed May 13, 1975, Serial
18 No. 576980, entitled Player operated game apparatus.

19 I direct your attention to the latter part
20 of that document, which includes copy of the paper
21 that we referred to earlier, namely the one captioned
22 Program Logic Array Unit in Minomic Code, and one sheet
23 of what is apparently a program listing. I ask you,

1 sir, with that in front of you, does that refresh your
2 recollection as to the size or extent of the program
3 listing that you originally read with the application
4 as filed?

5 A The size, yes.

6 Q Could you tell me what your recollection is
7 now?

8 A It would be advancing an opinion, but the
9 program was longer than that.

10 Q It was longer than that?

11 A Yes.

12 Q Is it your present belief that ^{is} the one that
13 was with the application as filed?

14 MR. TARRING: Would you specify what you
15 mean by that is the one?

16 Q The longer one that you are referring to.

17 A Yes.

18 Q Is it your testimony then, referring again
19 to this second sentence indicating that the software
20 ~~has~~ ^{had} just been recieved, that you were in error when
21 you made that statement in the office action?

22 A Yes.

23 MR. WELSH: While we have this document out,

1 I would like to request it be marked as an exhibit.

2 MR. GOLDENBERG: I would like this document
3 that we have referred to just a moment ago marked for
4 identification as Defendant Williams Deposition Exhibit
5 No. 1, and we will furnish copies.

6 (The document referred to was

7 marked Williams Deposition

8 Exhibit No. 1 for identification.)

9 Q Mr. Hum, directing your attention to the inter-
10 view with Mr. Katz on June 14, 1977 at which you dis-
11 cussed with him the exclusion of pinball elements in
12 the claims, we were asking questions about that earlier
13 this morning, do you recall? If I have misstated, sir,
14 please correct me.

15 Q We did not discuss exclusion.

16 Q You discussed inclusion of pinball elements
17 in the claims.

18 A Yes.

19 Q Did you say to Mr. Katz if such elements were
20 included you would allow the claims?

21 A I don't remember specifically.

22 Q Did you say anything suggesting or indicating
23 to him that you would more than likely allow the claims

1 if such elements were included?

2 A. I believe so.

3 Q. Did this then lead to the discussion wherein
4 this language of moving mass was agreed upon?

5 A. I believe so.

6 Q. I believe it was your testimony, sir, that you
7 had earlier in the history of the application suggested
8 that if limitation as to pinball machines were inserted
9 in the claims you would consider them allowable, is
10 that correct?

11 MR. WELSH: I object to the question. You
12 are characterizing his testimony.

13 MR. GOLDENBERG: If I am characterizing it
14 incorrectly, Mr. Hum can correct me.

15 MR. TARRING: I don't recall that part of
16 the testimony, either.

17 MR. GOLDENBERG: My notes tell me that, and
18 I am attempting to resolve the matter, but the record
19 will show. We could have the reporter find it, but
20 we will not do that.

21 Q. According to your recollection whether you
22 had in some previous occasion in acting upon the
23 application, my attention has been directed to the

1 first office action which was mailed on February 26,
2 1976, and is Paper number two in the application, and
3 specifically the last page of page four of that office
4 action. I would ask you to read the paragraph that
5 number five there, and then tell me whether or not
6 your recollection was refreshed with respect to the
7 outstanding question.

8 A Yes.

9 Q Could you now answer the question, sir?

10 MR. WELSH: What question is outstanding?

11 MR. TARRING: Could we have the question read
12 back. I think there is an outstanding question.

13 MR. GOLDENBERG: There is an outstanding ques-
14 tion, but I will withdraw it and I will ask another
15 question.

16 Q Having looked at the document, sir, isn't it
17 a fact that you had earlier suggested to the applicant
18 that if limitations directed to a pinball machine were
19 included in the claims, then the claims could be
20 allowed, is that correct?

21 MR. TARRING: Right here, I think we are
22 getting into an area where we are interpreting the file
23 wrapper to a large extent. I think the file wrapper

1 speaks for itself.

2 MR. LYNCH: Mr. Tarring let me say one thing.
3 People are always saying documents speak for themselves
4 and I have never heard a document speak no matter how
5 close I get my ear to it. Mr. Hum is the person who
6 generated these documents. This is a document that is
7 an open file, and insofar as Mr. Hum is setting forth
8 a position of the Patent Office in writing to the
9 applicant saying the claims would be allowable given
10 X, Y and Z, it seems to me the examiner is entitled
11 to pursue, not how he came out there, not his mental
12 processes for coming out there, but certainly to say
13 this was the Patent Office's position at this time, and
14 to take the comment out of the jargon of the Patent
15 Office and place it into context that a judge will
16 understand, and consequently, if we ask Mr. Hum what's
17 the position of the Patent Office at that time as
18 reflected by his comment, I don't think we are asking
19 for his mental process. We are asking for the outcome,
20 his final position as of this time, and then we may ask
21 how that final position evolved or changed as the
22 examination procedure continued. I fully appreciate
23 that drawing the line between mental process and non-

1 mental process is difficult, even recollection is a
2 mental process.

3 In this instance, I think we are entitled to
4 say when the examiner says if applicant claims one to
5 a pinball machine, this is a Patent Office position as
6 to the patentability at this juncture, and it seems to
7 me we are entitled to examine him about this Patent
8 Office position to articulate and make it clear.

9 res) MR. TARRING: My problem really is where we had
10 a problem in making clear what the record said, we went
11 a little bit beyond where we normally would. I can't
12 see how a judge could misinterpret the written word.
13 I don't see where there is a problem with a judge
14 understanding that, and your articulating it five or
15 six different ways wouldn't make it any clearer.

16 MR. WELSH: I agree with Mr. Tarring. I
17 believe your question is calling for interpretation
18 of the document, and that is not a proper question for
19 this witness.

20 MR. TARRING: I tell you what; if you want to
21 ask Mr. Hum factually, besides this document, if he
22 communicated by telephone, personal interviews, whatever
23 with the applicant, a position, as you indicate, okay.

1 However, if we are going right back to this
2 document and what it says, as being the communication
3 which you are referring to, we are really interpreting
4 a perfectly clear document.

5 MR. LYNCH: I think we are entitled to ask
6 Mr. Hum did the Patent Office have a position at this
7 time about the allowability of this claim, what was
8 that position, and you can look at this document to
9 refresh your recollection. It is an entirely appro-
10 priate question, and this idea that documents speak
11 for themselves would eliminate exhibits from depositions.
12 All you would do is let the reporter annex them, and
13 let them speak or copy them down. We cannot do that.
14 So it seems entirely appropriate to ask what was the
15 Patent Office's position at this juncture.

16 MR. WELSH: That was not the question.

17 MR. TARRING: I think even there, that is
18 calling for the examiner to provide an interpretation
19 of the file wrapper.

20 MR. GOLDENBERG: That was put there solely to
21 refresh his recollection; that was the sole purpose
22 for which it was offered.

23 MR. WELSH: I think you have to look at it

1 question by question. What Mr. Lynch is interpreting
2 the question to be, I believe is not quite what the
3 question is.

4 MR. LYNCH: That very well may be. I am
5 stating the position that we are entitled to get. My
6 turn is coming, and I realize this is a very difficult
7 area.

8 MR. GOLDENBERG: Can we have an understanding
9 that the document that we are all presently looking
10 at and that last paragraph states the Patent Office's
11 position at that time?

12 MR. TARRING: It's a signed Patent Office
13 communication at the time, I don't see where there
14 could be any problem with that.

15 MR. GOLDENBERG: You would agree that at the
16 time of the document that was the Patent Office's
17 position?

18 MR. TARRING: Yes.

19 MR. GOLDENBERG: At the subsequent interview
20 on June 14, 1977, again, can it be agreed that Mr. Hum
21 was stating the Patent Office's position, namely, that
22 if limitations directed to a pinball machine were
23 inserted, then the claims would be allowed?

1 MR. TARRING: I simply don't recall that
2 testimony.

3 MR. WELSH: I don't recall those words. He
4 said nothing about it being allowed. The record will
5 speak for itself, and this is your characterization
6 of his testimony and asking for an interpretation from
7 Mr. Tarring, I think is completely inappropriate. He
8 is not a party to the lawsuit.

9 MR. GOLDENBERG: We are doing no more than
10 attempting to find out what happened during the
11 prosecution of this application.

12 MR. TARRING: Insofar as what the facts of
13 what occurred are concerned, you are welcome to them.
14 Where we start interpreting the file wrapper, I have
15 trouble with that.

16 Q Let me ask this question, Mr. Hum, there was
17 conversation between you and Mr. Katz about the in-
18 clusion in the claims of limitations directed to a
19 pinball machine, that is true, isn't it, sir?

20 MR. WELSH: I object to the question.

21 MR. GOLDENBERG: We are talking about the
22 interview of June 14, 1977, when Mr. Katz was in your
23 office.

1 A I don't remember whether or not I mentioned
2 pinball limitations or pinball type limitations.

3 Q What distinctions do you draw between pinball
4 limitations and pinball type limitations?

5 MR. TARRING: I don't think we are here to get
6 what distinctions he's drawn. We are here to get what
7 was discussed. We are here to get what factually
8 was communicated between the two, not the distinctions.

9 MR. GOLDENBERG: I am only interested in the
10 distinction he is drawing at this time in connection
11 with the answer he just gave, that is all. I assure
12 you my question is not intended to inquire into the
13 state of his mind at the time of the interview.

14 Q I direct your attention again to the amendment
15 D, which I believe is Paper number eleven in that file,
16 and Page 18 particularly, and the paragraph starting
17 however. I ask you to read that paragraph, sir, and
18 then tell me whether or not it refreshes your recollec-
19 tion as to whether there was any discussion with Mr.
20 Katz about putting limitations in the claims about the
21 pinball machine or relating the claims to a pinball
22 game?

23 MR. WELSH: I object to the question as being

1 stated in the alternative, and including more than
2 one question.

3 Q Can you answer the question, sir?

4 A Would you repeat the question?

5 Q Let me withdraw it and restate it.

6 Upon reading that paragraph, is your recollec-
7 tion refreshed as to whether there was any discussion
8 about amending the claims to include limitations
9 directed to a pinball game?

10 A No. I don't remember.

11 Q You did earlier, I would like the reporter to
12 go back and give your earlier testimony.

13 You really, at this time have no recollection
14 as to whther there was any discussion?

15 A Not to your specific question.

16 Q Was there any discussion in any way connected
17 with amending the claims to put in limitations directed
18 in some way to a pinball game, and this is at the inter-
19 view of June 14, 1977 with Mr. Katz?

20 MR. WELSH: Your previous question was
21 referring to an October 17 amendment, and now you are
22 referring back.

23 A I don't recall with respect to the specifics

of the question.

Q Could you tell me what specifics?

A Could you repeat the question again?

Q You do recall the interview with Mr. Katz on June 14th?

A Yes.

Q Do you recall whether or not on the occasion of that interview you had any discussion with Mr. Katz about amending the claims to insert limitations directed in some way to a pinball game?

A I don't recall if we discussed limitations directed to a pinball game.

Q Do you recall what you discussed about anything sounding like that or relating to that topic?

A Possibly sounding like that.

Q Don't you recall telling me about reaching an agreement on the language, or the phrase, moving mass?

A Yes.

Q Don't you recall that you told me earlier the reason you reached agreement on this phrase is that Mr. Katz and you discussed some kind of game where there was a vertical motion of some kind as opposed to the horizontal motion of pinball games?

A Yes.

MR. TARRING: That was the reason and that is what bothers me.

MR. WELSH: I object to covering the same ground we covered before.

MR. GOLDENBERG: There is confusion on the matter, Mr. Welsh, and I regret it just as much as you do, but I think the matter should be made as clear as we can for the court, that's all.

Q Did you say to Mr. Katz, on the occasion of that interview, if limitations directed to pinball games were inserted in the claims that you would consider them favorably from the point of view of allowing them?

A May I confer with counsel?

Q Please.

MR. WELSH: I object to the question as mischaracterizing the previous testimony of the witness, actually trying to put words in his mouth.

A With respect to your question, it would require interpretation on my part of language that you used, and I just don't remember specific events with respect to your specific question.

1 Q Perhaps it will come back to you. In the
2 meantime, let me ask you this question, here again, I
3 direct your attention to the first office action in
4 this application, the one dated February 26, 1976 on
5 Page 4, and this paragraph; If applicant includes and
6 claims one and twelve limitations directed to a pinball
7 machine and associated elements, eg. player operated
8 flipper means, ball means, and projector means, etc.
9 correlated to claimed structure, and if the indefinite
10 portions are clarified, then claims would appear
11 allowable.

12 Have you read the sentence, sir?

13 A Yes, I have read the sentence.

14 Q What was the factual basis for that state-
15 ment at the time it was made?

16 MR. TARRING: I have difficult interpreting
17 that, and I am sure he does to. I am not sure he
18 knows what you are asking for. Do you understand
19 the question?

20 THE WITNESS: Not unless he is referring
21 to the decision making process.

22 Q What facts did you know at that time that led
23 you to make that statement to the applicant?

1 MR. TARRING: I am going to direct him not
2 to answer that. It is going into mental processes
3 and calling for interpretation of facts that are un-
4 specified. It is too broad, and I don't think he
5 understands it.

6 MR. GOLDENBERG: Do you advise the witness
7 not to answer the question?

8 MR. TARRING: Yes.

9 Q Mr. Hum, at the time you made that statement,
10 or Mr. Katz said to you during the next interview
11 sir, did you know that pinball games were old?
12 that occurred?

13 A Yes.

14 Q Did you know that microprocessors were old
15 correlation with
16 and in the prior art at the time you made that
17 statement?

18 MR. WELSH: I object to the question as
19 indefinite as to what is meant by prior art, and
20 calls for his opinion.

21 MR. GOLDENBERG: I am referring to prior art
22 in the Patent Office.

23 Q Did you know, at the time you made your state-
ment that microprocessors were in the prior art?

A Yes.

(Whereupon, at 12:15, the deposition was
recessed until 1:15 p.m.)

AFTERNOON SESSION

(1:15 p.m.)

BY MR. GOLDENBERG:

Q Following the interview that we were inquiring about this morning, that is the one that occurred on June 14, 1977, what is the next interview that you remember?

A I don't think I can give you a date.

Q Do you recall anything that you said to Mr. Katz or Mr. Katz said to you during the next interview that occurred?

MR. WELSH: "I object. There's been no foundation laid."

Q Was there more than one interview, sir?

A I don't remember.

Q You don't remember if there was more than one?

A No, I don't.

Q Let me direct your attention to a paper captioned Supplemental Amendment, and bears date stamp of being received November 18, 1977, and I think it is Paper number 13. I direct your attention to Page 5 of that amendment, and the first sentence under remarks. I direct your attention to that, and I would ask you if that refreshes your recollection as to whether or not

there was an interview after the interview of June 14, 1977?

A Yes, to some extent.

Q Do you have any recollection, sir, as to what was said at that interview, either by you or by Mr. Katz?

A To a certain extent, yes.

Q Do you now recall that there was an interview on or about that date?

A Yes.

Q Could you tell me, to the best of your recollection what was said by you or by Mr. Katz on the occasion of that interview?

A I won't address the question chronologically because I don't remember the order in which it came up.

Q Understood.

A I believe I brought up a new reference that I found. It is noted on Page 5, Patent number 402655. I believe we discussed the subject matter there. I don't remember what transpired specifically with respect to this reference.

I ^{vaguely} ~~vaguely~~ remember discussing the subject matter referred to in the last paragraph on Page 5 of

Amendment 13.

Q I think it is Paper 13.

A All right, Paper 13. I remember discussing certain information, certain formal matters with respect to the claims, but as to the specifics of this interview, I can't remember.

Q Do you recall what you said to Mr. Katz about this additional reference, Patent No. 402655?

A I can't remember.

Q Do you recall what Mr. Katz said to you about it?

A No, I don't.

Q Directing your attention to Page 6 and the next to the last paragraph in which you are reported as saying, if you note any other matters requiring formal amendment, you would call the undersigned attorney. Did you make any such telephone call?

A May I refer to the file wrapper?

Q Please do.

A I don't remember.

Q You don't remember whether you did or not?

A Correct.

Q Do you remember any interview or interviews

that took place after the interview in November?

A: You mean --

Q In connection with this application.

A I refer to this paper, this is November?

Q Yes, and that refers to a November interview.

My question to you: do you remember any interview or interviews taking place after the November interview?

A I don't remember.

Q I would like you to turn to a paper captioned Amendment CFR, Section 1.312 which was apparently filed in the Patent Office on February 2. You have that paper in front of you now, February 2?

A Yes, a paper, number 22, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23.

Q I direct your attention to Page 2 of that paper, and the first paragraph of that page, and would ask you to read that paragraph.

Do you now remember any interview or interviews after the November interview?

A Vaguely, yes.

Q Do you recall whether that interview was conducted over more than one day?

A No, I don't.

Q You note in the paragraph that I called to

your attention that, do you have any reason to believe that is not true?

A No.

Q Do you remember who was in attendance at that interview?

A I believe it was just Mr. Katz.

Q Have you ever had any interviews in connection with this application in which there has been more than one person in attendance representing the applicant?

A I don't think so, but I am not certain.

Q Let's focus in on the interview record on Page 2 of this paper, number 18. Do you have any recollection, at this time, of what was said to you by Mr. Katz or what you said to him in the course of the interview?

A Vaguely.

Q Could you give me the extent of that recollection, sir?

A I vaguely remember discussing the Bally Alley Service Manual referred to in this Page 2 of this Paper number 18.

Q Do you remember what was said by yourself or

by Mr. Katz during that discussion?

A No, I don't specifically remember.

Q Did you read the Bally Service Manual during the course of that interview?

A During the course of the interview?

Q Yes.

A Not at full length.

Q Did you read portions of it?

A I believe I did.

Q Were those portions to which your attention was directed by Mr. Katz?

A I don't remember.

Q Is the Bally Alley service Manual in that file you have in front of you?

A Yes, not certain if it had been printed.

Q Could you identify or recall at this time which portions you read?

A I don't remember what portions I read during that interview.

Q Did you read the Bally Alley service manual at any other time?

A Yes, according to the

Q When did you do that?

A I can't give you specific dates.

Q Was it after the patent issued?

A Oh, yes.

Q What led you to read it?

A I am afraid I can't answer that question.

Q Is it you don't remember what the reason was?

A Well, the reading of this occurred with respect to another application. I am bound by 35 USC 122 not to answer.

Q You read it in connection with the examination of some other application or applications, is that it?

A Yes.

Q At the time, if I understood your testimony, that was after Patent 4093232 had issued?

A I am not certain if it had been printed at that time, but to the best of my recollection, after it had gone beyond my jurisdiction.

Q At the time of the interview, sir, did Mr. Katz explain to you what the Bally Alley game was?

A You mean the immediate interview?

Q This interview you referred to in Paper No. 18 taking place, according to the paper, on January 24, 25

A I don't remember.

Q Did he explain or state to you that the Bally Alley game was controlled by a microprocessor?

A I don't remember.

Q Did Mr. Katz say anything to you about the game, its construction or mode of operation, other than what appears in the Bally Alley Manual?

A I don't remember.

Q Did he tell you the microprocessor in that game was an Intel 4004 microprocessor?

A I don't remember.

Q Did he tell you that the lamps constituting part of that game were connected in a matrix?

A I don't remember.

Q In the course of that interview, did you come to understand the game Bally Alley?

MR. WELSH: Object to the question as calling for a mental process.

MR. TARRING: I think that is calling for a conclusion.

MR. LYNCH: I think understanding the operation of a device is a fact.

MR. GOLDENBERG: Whether or not he understood it, sir. I am not going into his mental process. I

am not going into why he did what he did. I am attempting to ascertain the extent of the witness's knowledge and time of a specific event.

MR. TARRING: Why not just ask him if he reviewed it at that time.

MR. LYNCH: Insofar as anything is a mental process, then everything gets processed through the mind and recollection, and everything else, but it is a fact as to whether the examiner at one time or another had a thorough understanding of circuit operations. That is all I am talking about here. I would encourage you to reflect on that.

MR. WELSH: I would like to point out that is clearly within the protection of the protective order in calling for the basis of mental processes or conclusions of the examiner acting upon an application.

MR. LYNCH: May I make one other statement for the record. Communications were had with the examiner and they are reflected in this file. It seems to me entirely appropriate to inquire whether there was an understanding of the operation of an electrical device. To limit the testimony, to forbid an inquiry as to whether there was an understanding of

of circuit operations is really to absolutely prohibit any knowledge as to whether there was an appreciation of the teaching of the references.

MR. WELSH: That goes to the mental process and not what went on in the interview.

MR. TARRING: I tend to think the whole focus is a little bit askew, how well he understood this or understood that, the fact is the patent is issued and whether the patent is something that was properly or improperly issued is something that will stand on its own two feet, and not a rehash of the examiner's understanding.

MR. GOLDENBERG: That doesn't quite do it really, because there are certain presumptions when the Patent Office issues a patent. You know that as well as I do, and that is the law, and indeed you referred to that in your opening statement here. I think we are entitled to explore, by discovery, as to whether or not those presumptions should have any vitality to them. At this point, I don't know whether they do or not, and that is all we are inquiring into, and the questions are factual questions. The mental reasoning of Mr. Hum is not a thing that we are

inquiring about. We are inquiring into his understanding of something that was represented to him by the attorney for the applicant as prior art, and that is all we are doing.

MR. WELSH: That is synonymous for mental process.

MR. GOLDENBERG: You know there are various ways of dealing with presumptions.

MR. LYNCH: If you would consider the fact that this is a situation where a piece of art is presented to Mr. Hum, he didn't come across it himself. It was presented to Mr. Hum at an interview. We have a situation where this has now been placed on the face of the patent, and there is a presumption that may or may not be, but let's assume the patented to be relied upon to take the position of presumption of validity of the patent over that reference.

Now it seems to me that any legitimate inquiry which goes to the understanding of that, the fact of that understanding, goes to the matter that is involved in the prosecution.

MR. WELSH: You are seeking to make the witness an expert to give you his understanding of

what, as a person skilled in electronics, of what the operation of the Bally Alley is, and that would call for another objection.

MR. LYNCH: I think this matter was brought to Examiner Hum's attention by the patentee. It seems to me it is entirely appropriate to ask Mr. Hum what his understanding was of the applicability or operation of that particular circuit. And this is, of course, after the notice of allowance had been set out, and the item was made a matter of record in the Patent Office. Are any representations made

MR. TARRING: I will let you inquire as to the extent of the study of the device. As far as the remainder of it goes, I am not going into a situation where we are going to talk about this and that element, how does it work, and not going to discuss a Bally Alley examination.

As far as the examiner is concerned, you know his background, it's been established, and it is presumed he is competent. To the extent that he looked at that thing, that is okay, but insofar as how does this work, how does that work, that is entirely disruptive of the executive process in this area. I

cannot imagine a judge standing for his being questioned as to what he understands of this or that.

I think that is basically what is being inquired into. As far as what physically happened, as far as the extent of his study, fine, but I don't go for it beyond that.

MR. GOLDENBERG: I take it you are advising the witness not to answer the question.

MR. TARRING: Not in the broad sense.

BY MR. GOLDENBERG:

Q Were any representations made to you by Mr. Katz about the operation of the Bally Alley game?

MR. WELSH: I object to the question. You have already asked the question, and he said he didn't recall how Bally Alley works.

A I don't remember.

Q Did Mr. Katz say anything to you, sir, about the Bally Alley game including a number of lamps connected in a matrix and the lamps were controlled by multiplexing?

A I don't remember.

Q Do you recall whether he said anything to you about how the digit displays were connected to the

microprocessor?

A No, I don't remember.

Q Do you recall whether or not you knew, at that time, there was a microprocessor controlling the game?

A I don't remember, not at that time.

Q Did you later acquire such knowledge?

A Yes.

Q What was the source of that knowledge?

A I have to invoke 35 USC 122.

Q This is because this was in connection with notes during the interview, after I asked the case, some other application?

A Correct.

Q Did you acquire that knowledge from studying the service manual?

A Yes.

Q From that study of the manual, were you able to identify the microprocessor that was involved on this later study?

MR. TARRING: Wait a minute. We are talking about something that is occurring in another application. I don't think that is appropriate.

MR. GOLDENBERG: I will withdraw the question.

Q Did Mr. Katz, at the time of that interview, say anything to you that the lamps constituting a part of the game were turned on and off rapidly so as to eliminate flicker?

A I don't remember.

Q Did you make any notes of that interview, sir?

A I believe I did.

Q Where are those notes?

A I no longer have them in my possession.

Q Do you know where they are?

A No, I don't. I generally make handwritten notes during the interview, after I allow the case, I generally destroy the pencil notes.

Q Do you believe you did that in this case?

A Yes.

Q Are you familiar with any Patent Office practice or procedure with respect to examiners recording what takes place at interviews?

A Yes.

Q Did you follow that practice?

A At the time I followed the office policy, yes.

Q Did this office policy, at the time of any of these interviews, require that if there was an agreement

reached, the recordings of those interviews should be signed by the attorney and examiner?

A Could I confer with counsel?

Q Surely.

A Could you read that back?

(Question read back)

MR. WELSH: Object to the question, the original question was with respect to that interview regarding Bally Alley. Now your question calls for any of those interviews. I think your question is indefinite. What do you mean by any of these interviews?

Q Can you answer the question, sir?

A As far as office policy is concerned, I don't think we are required, if the record was complete in our determination.

Q And you did not do it in this case?

A No.

Q But it was a suggested procedure, was it not, during the period you were acting on this application?

MR. WELSH: That is if an agreement were reached? I object to the question, it is indefinite as far as what is meant by that accepted practice.

MR. GOLDENBERG: I withdraw the question.

Q In the course of the past few moments, since we have been discussing this interview conducted apparently on two days, January 24, 25, have you had any additional recollections about what was said or done at that interview, sir?

A No, I haven't.

Q Did you, in the course of any search that you made while acting on the application we have been inquiring about, make any searches into the technical literature as distinguished from searches into Patent Office sub-classes of prior arts?

A I am not certain what you are asking. May I explain my answer?

Q Please do.

A Our files are set up so that we have some technical literature in the shoes, but from time to time, we also can search in a scientific library for technical literature. I don't know what you mean by searching for technical literature.

Q Did you, in this instance, search in the scientific library of the Patent and Trademark Office?

A No, I didn't.

Q The word shoe that you used earlier, can we

agree that is a file drawer in a stack of file drawers as used in the Patent Office?

A Yes.

Q I notice in the patent, column eight, bottom of the column, there is a reference to an Intel NCS-40 Users Manual for Logic Designers. Did you consider the contents of that document during the course of your examination of the application for the patent that ensued?

A I don't believe so.

Q Did you consider the contents of any publication or document issued by Intel Corporation, in connection with the operation of the 4004 micro-processor?

MR. WELSH: At what time?

Q In the course of your examination of the application for the patent that ensued, did you consider any publication or document issued by the Intel Corporation which related to the M 4004 microprocessor or its use?

A I don't believe so.

Q How sure are you of that answer, sir; are you reasonably sure?

A Reasonably sure.

MR. GOLDENBERG: I have no further questions.

EXAMINATION IN BEHALF OF D. GOTTLIEB & CO.

BY MR. LYNCH:

Q Just one matter, you did receive a subpoena to appear here, did you not?

A Yes. You said a search of the records.

Q Did you receive one from both Williams and Gottlieb?

A I received two. I didn't look at the names.

Q I believe the record will reflect that one was served by defendant Williams and one was served by defendant Gottlieb. I believe that was the area my office consulted with Mr. Tarring.

MR. TARRING: Your office called with respect to that, and your office called before that, as I indicate exactly where he resided. recall.

MR. WELSH: We haven't seen copies of the subpoena.

MR. TARRING: I am perfectly willing to talk with anybody about what our responses will be at a deposition.

Q You were served with two subpoenas?

A Yes.

Q You received the patent application and the patent ensued. I believe you stated you read it, and then what did you do in connection with your examination?

A Made a search of the prior art.

Q When you made a search of the prior art, what were you looking for? What

MR. WELSH: Object to the question as calling for his mental process and analysis of the application to determine what subject matter he was going to seek to search. I think it is a completely improper question.

MR. TARRING: I agree it is designed to reflect upon his analysis of the case. I would point out that the patent file, as a normal course of events, will indicate exactly where he searched.

Q I asked what he was looking for. What did you find?

A I found prior art.

Q What did you find with respect to pinball machines? If you would, Mr. Hum, to refresh your recollection, you can look at the first office action.

MR. TARRING: I will advise the examiner he can answer if he recalls things that he found that are not already indicated within the file wrapper itself. Insofar as what is clearly in the file wrapper itself, that seems to be a redundancy in spades.

MR. WELSH: I object to the question also, what is meant by what did he find.

Q I am talking about what references he found that referred to pinball machines that related to the subject matter of this application.

A According to what I believe I noted that in the prior art. Qs. It's a fact, Mr. Hum, you didn't find any reference to use of a microprocessor in a pinball machine?

MR. TARRING: Just a minute. Here again, by forming a question in a particular manner, we are trying to get the examiner to characterize things which are or are not in the record. As far as the record is concerned, I think it speaks for itself.

MR. LYNCH: I am not talking about the record. I am talking about whether he found a reference to ~~microprocessors~~ ~~microprocess~~ being used in a pinball machine?

MR. WELSH: I object to the question as

improper. By the use of the word find, you imply that he was looking for something, and that is improper because it requires, or inquires into his analysis of the application to determine what he considered to be the invention, what he was looking for by way of prior art, and to ask him what he found implies that he was looking for something, therefore, I object to this question. I think I wasn't looking for it.

MR. TARRING: I would suggest you ask if he found anything other than what is indicated in the art of record in the way of pinball machines that he recalls by references referred to.

MR. LYNCH: I can ask if he found anything other than what is reflected in the art of record that referred to the use of microprocessors in a pinball machine? I can ask him that?

MR. WELSH: If he recalls.

MR. TARRING: Do you understand the question?

MR. WELSH: Before he answers, I would like to call attention to a list of questions which were in the deposition that involved going before the court here in the District Court of Virginia to determine the propriety of these questions, and one of them

that was found to be improper, did you look for such a reference.

MR. LYNCH: I am asking him what he found.

MR. WELSH: To find something, you have to be looking for it. It is implicit in the question did you find something, what were you looking for.

MR. LYNCH: I think that is a nonsequitur; I found a lot of things I wasn't looking for.

MR. TARRING: I think that underlies a lot of the problem with this line of questioning.

MR. LYNCH: It was indicated, I think, if he found any references referring to microprocessors used for operating pinball machines other than those cited.

MR. TARRING: To the extent he recalls.

Q To the extent you recall.

A Can I refer to the file?

Q Yes.

MR. TARRING: Could I ask if there is more than one 892, that is the list of references?

Q I am talking about the first search. I am talking about the beginning. I asked what he did, he said he searched the art. In connection with that

first search, that is all I am talking about.

A Could you repeat the question, please?

Q Did you uncover a reference, other than the references set forth in this notice of references dated 12-15-75, in the initial search on this application which related to a microprocessor in a pin-ball machine?

A No.

Q Did you find references that related to microprocessor-controlled arcade games generally?

A In this search?

Q Yes.

A No, not on this search.

Q Are you now aware of whether computer operated arcade games were in the prior art as of the time the patent application of the patent suit was filed?

MR. TARRING: I have some difficulty with that. That is completely beyond the scope of the examination of this case.

MR. LYNCH: There is a comment in this action. Reference R, Page 4, right before this note, there is an indication reference R teaches the well-known fact that computerized games are old. Number 6 on Page 5

of the office action dated February 26, 1976.

Q At the time you made this search, Mr. Hum, were you aware that microcomputer operated games were in the prior art?

A No.

Q In the file wrapper, on the inner cover, and not appearing on any -- I guess it probably does appear or perhaps appears -- but on the inner cover above the printed word search, there is a notation consulted Stewart in Class CL 179-15 on time dif mux. Did you make that note in your handwriting?

A Yes.

Q What does that note mean?

A I consulted with Mr. Stewart in Class 179, sub-class 15 on time division multiplexing.

Q Do you remember if that was in connection with your original search?

A Yes.

Q What did you find about time division multiplexing in your discussions with Mr. Stewart. I want to know what facts he was told. I don't want to know what his discussion was. I want to know what the results of that factual information was.

MR. TARRING: It goes to his analysis and his intermediary conclusions in deciding what to do. What he did with the case, I think is quite clear.

MR. WELSH: I object on the grounds that it calls for his analysis.

MR. LYNCH: I do not want to know the analysis. What I want to know what facts he came away from that meeting with. I don't want to know anything about his conversation with Mr. Stewart. There is a notation on this file, that the examiner saw fit to put on there. This is a public document, and I am entitled to ask what that notation means, and what the results of that consultation means.

MR. TARRING: He's told you what the note says. That is what he felt appropriate to put on the file, and he's given you a full explanation of it.

MR. GOLDENBERG: It is not a full explanation of it, sir.

MR. TARRING: This is an interoffice consultation with regard to reaching his conclusions with respect to this application. I do not think that such consultations are open to this kind of discovery.

Q Who was Mr. Stewart?

A I don't remember. I don't think -- it's too far back in the past to remember.

Q Was he a patent examiner?

A Yes.

Q Where it mentions a class in connection with his name, does that indicate the area in which he was examining patents, the art classification in ^{which} ~~enich~~ he was examining patents?

A I don't know.

Q Are those Classes 179-15 in your art unit?

A No.

Q Now below that reference to Mr. Stewart that I asked you about, there is another reference, can you read that?

A Semi-colon Chapman and Shaw in Class 340 sub-class 172.5.

Q What was the nature of your discussions with Mr. Chapman and Mr. Shaw?

MR. TARRING: Again, I think we are in the same area. We might verify -- were Mr. Chapman and Mr. Shaw patent examiners?

THE WITNESS: Yes, they are patent examiners.

Q Did you consult with them about the action you

were going to take on this application, or did you consult with them about facts that existed in the prior art?

A. Facts with respect to the prior art.

Q Is that what you consulted with Mr. Stewart about as well?

A Yes.

Q What did you find factually with respect to the prior art?

MR. WELSH: I object to the question on the grounds that it inquires into the analysis of the examiner of the application and the art which he felt to be relevant to his searching to determine what his action would be acting upon the patent application, and that is exactly the type of inquiry that is restricted by the protective order in the Stafford Sharrer Tool case.

MR. TARRING: I am not sure I am going to let him answer it.

Would you mind clarifying your question? I find it is extremely broad.

MR. LYNCH: He consulted with these people and listed it in the prior art. All I want to know is

what he found out, as a matter of fact.

MR. WELSH: That is calling for hearsay, and if it is not calling for hearsay, it is delving into the decision making process.

MR. TARRING: I am still perplexed as to what you are after. It obviously means something to you, but I am not sure this means anything to me.

MR. LYNCH: This has nothing to do with his decision making process.

MR. TARRING: I think it does.

MR. LYNCH: I don't believe it does at all.

MR. TARRING: In the broad sense you are asking it does; you might narrow the context.

MR. LYNCH: What narrower context are you talking about that you will permit the answer.

What I am trying to figure out, the examiner has indicated that he made an inquiry of Mr. Stewart, and these other gentlemen, in connection with multiplex and the fact that was in the prior art with regard to multiplex. I want to know what he found out from those inquiries, that's all.

MR. TARRING: Do you want to ask if he was directed to any specific patents in those areas?

That would be specific.

MR. GOLDENBERG: Well, were you directed to --

MR. WELSH: I would like to inquire if Mr. Goldenberg is still examining.

MR. GOLDENBERG: I am defending my client; that is all I am doing, sir.

Q I want to know one thing; what did Mr. Stewart and the other two gentlemen point out to you about what existed in the prior art with respect to multiplex?

A Mr. Shaw and Mr. Chapman are not involved with multiplex.

Q What are they involved with?

A Computers.

Q Did Mr. Stewart point out any specific references in the prior art?

A No.

Q Did Mr. Stewart tell you anything about the prior art that had to do with multiplex?

MR. WELSH: Object to the question.

MR. TARRING: You have gone too far.

MR. LYNCH: Mr. Tarring, the examiner went to the gentleman to ask about facts of what existed in

the prior art.

MR. TARRING: The examiner went to the gentleman to assist him in reaching his conclusion in doing his job.

MR. LYNCH: His testimony was that he went to them for facts about what existed in the prior art.

MR. TARRING: So?

MR. LYNCH: That is what I am trying to get.

MR. TARRING: Why don't you ask him if he found out any facts?

BY MR. LYNCH:

Q Did you find out any facts about what existed in the prior art with respect to multiplex from Mr. Stewart?

A No.

Q MR. LYNCH: That is the question I wanted to ask originally.

MR. TARRING: You asked what facts, you didn't ask yes or no.

MR. LYNCH: The answer can be none.

MR. TARRING: The question is what I have to go by. Bring it down to something I can handle.

Q Now, in all of the searches that you conducted

in connection with this application, do you recall if you found any art which was directed to a microprocessor operated pinball game?

MR. WELSH: Object to that question on the same grounds as before.

MR. TARRING: I have a great deal of difficulty with these broad questions. If you have a specific piece of art that he was aware of, that would be more specific.

MR. LYNCH: That, Mr. Tarring, is a very narrow question -- microprocessor operated pinball game.

MR. TARRING: It remains unfixed on any piece of prior art. I don't know. Are we going to do a lot of these kinds of questions. I can visualize people dreaming up new concepts to ask about.

MR. LYNCH: This is not a new concept. This is the only question in this regard that I intend to ask.

MR. TARRING: Of that nature?

MR. LYNCH: Yes.

MR. WELSH: I object to this question because it refers to searches which were part of the examining

process, and what he found which involved what he was looking for, and that involves his analysis. As worded, that question is improper.

Q I would like to know if you found, in connection with any of your searches, a prior art reference which referred to the microprocessor pinball game, to the extent you recall.

A May I make a request of counsel?

Q Yes.

MR.. TARRING: Is there any other reference in here?

Q There is another reference of office action on 11-5-76 Popular Electronics ^{Altair 8800} ~~Altair 880~~, and another reference cited in the office action of 12-8-77 which is ^{Kirschner} ~~Kuehner~~, and I have them if you would like to look at them.

A Not to an arcade base pinball game.

Q Not to an arcade base pinball game?

A I believe that was your question.

Q I said pinball this time.

A No.

MR. TARRING: If you have particular references that you have in mind, if you asked him what he is

1 aware of it might help.

105

2 MR. LYNCH: I understand that. If you were
3 in my position, you would have asked the same question.
4 Now, I am going to do it, we are not going to have
5 that much problem with it.

6 Q Now, Mr. Hum, I want to show you an ad which
7 appeared in the Electronics magazine dated March 21,
8 1974 for Intel Corporation which I will ask the
9 reporter to mark as Hum Deposition Exhibit No. 2.

10 (The document referred to was
11 marked Hum Dep. Exhibit No. 2
12 for identification.)

13 Mr. Hum, I call your attention in this ad to
14 the text to the left of the two small red checks that
15 I have placed, one on each page of Exhibit 2, and ask
16 you to review that generally, and in particular the
17 text opposite the red checks, and tell me if you were
18 aware of that advertisement during the examination of
19 the Nutting patent?

20 A No, I was not aware of this advertisement.

21 Q Were you aware of any reference that referred
22 to the use of the Intel 4004 microprocessor to be
23 used to control a pinball machine?

MR. WELSH: At what time?

Q During the examination of the Nutting patent application.

A Not during the examination of the Nutting patent application.

Q Have you become aware of such prior art since that time?

MR. TARRING: Such advertisement?

MR. LYNCH: No. Leave it where it is, such prior art. No. I will withdraw the question.

I will ask the reporter to mark as Hum Deposition Exhibit No. 3 a number of pages reproduced from Electronics magazine of October 25, 1973, Special Issue, the Great Takeover, pages 69 to 103 of Electronics magazine.

(The document referred to was marked Hum Depv Exhibit No. 3 for identification.)

Q Mr. Hum, I ask you to look at Hum Deposition No. 3 and particularly the top line on the righthand column on the page that follows Page 97, which is apparently Page 98, and ask if you were aware of this article during the examination of the Nutting patent

application. By that, I mean during your examination of the Nutting application, and while the Nutting application was in your jurisdiction.

A No, I wasn't aware of this reference.

Q I particularly refer you to the paragraph "On the burgeoning list of small systems being given an extra degree of "intelligence" and sales appeal by microcomputers are computers for the small businessman, electronic cash registers for hamburger stands, transducers that double as process controllers, pinball machines, self-calibrating medical instruments, traffic controllers, and a host of data terminals."

Is it your testimony that you were not aware of that portion of the article?

A No, I wasn't.

Q Were you ever made aware or were you aware of an electronic pinball machine designed by Bally-- were you made aware of any prior designs of electronically controlled pinball machines by Bally during the prosecution of the Nutting patent application?

MR. TARRING: Do you have anything specific to show what you are talking about?

MR. LYNCH: I would like to know if he was

aware, or was made aware of a design of electronically controlled pinball machine by the Bally Corporation.

MR. WELSH: I object to the question as lacking a foundation, and assuming a fact.

MR. LYNCH: Let me ask the report to mark this as Hum Deposition No. 4, an article from *ee/systems engineering today*, November, 1973, Pages 37, 38, 39 and 40.

(The document referred to was marked Hum Dep. Exhibit No. 4 for identification.)

Q Mr. Hum, were you aware of that article during the time that the Nutting patent application was within your jurisdiction in the Patent Office?

A No, I was not aware of this article.

Q Specifically, I would like to refer you, Mr. Hum, to the bottom of the righthand column on Page 37 of Hum Deposition Exhibit 4 where it says the following: the following quote is ascribed to Mr. Ross Schier, who is marketing manager of the Chicago-based Bally Corporation: "We've designed an electronic flipper machine where we could use solid-state devices probably more in memory functions than anyplace else--but found

1 our costs were higher than if we used traditional
2 methods and electromagnetic devices. We've gotten to
3 be proficient in the way we're making machines now
4 that we've decided not to venture into solid state."

5 During the prosecution of the Bally application,
6 Mr. Hum, were you made aware of that fact that in 1973
7 Bally had designed an electronic pinball game?

8 MR. WELSH: I object to the question as
9 assuming a fact, stating a fact that has not been
10 proven as a fact. There is no foundation for the
11 question.

12 Q: Were you made aware of either the fact that
13 Bally had designed an electronic pinball game, or that
14 it was reported that Bally had designed such a game?

15 MR. WELSH: Object to that question as being
16 stated in the alternative, and therefore, indefinite,
17 and also assuming the fact that Bally had been reported

18 MR. LYNCH: That, I will make an offer of
19 proof on. I can prove that was published in 1973.

20 Do you deny it?

21 MR. WELSH: I am not going to comment on that
22 at this time.

23 MR. GOLDENBERG: You should after what you

1 just said.

110

2
3 MR. LYNCH: You are implying that I would put
4 before the witness some type of article which might
5 somehow be false.

6 Q Can you answer the question.

7 MR. WELSH: I am going to object. It assumes
8 as a fact something that has not been proven.

9 Q Were you aware during the time that the Nutting
10 patent was within your jurisdiction in the United
11 States Patent Office that Bally had designed, or had
12 been reported to have designed an electronic pinball
13 machine?

14 MR. WELSH: It's the same question and the
15 same objection. It's assuming a fact that Bally had
16 designed such a game.

17 MR. TARRING: The one thing that bothers me
18 about that question, what do you mean by electronic,
19 or does that mean something to you?

20 THE WITNESS: Electronic doesn't bother me;
21 pinball might. Could I have the question read back?

22 (Question read back.)

23 MR. WELSH: I also object to this line of
questioning to the extent that it might result in

violation of 35 USC 122.

MR. TARRING: Are your questions directed toward any other application that might be on file?

MR. LYNCH: No. Excluding any other applications that are on file, specifically excluding them.

A I think I would have to answer maybe.

Q What was the source of your information?

A A magazine article.

Q Do you know what magazine article that was?

A I don't remember.

Q Do you remember when you saw that magazine article?

A That is why the maybe, I don't remember.

Q Do you remember in what publication this magazine article appeared?

A Not specifically.

Q Do you remember what the subject matter or what your recollection tells you was the subject matter of this magazine article in the context of an electronic pinball machine having been designed by Bally?

A I think at this juncture it would violate

Q Did this magazine article come to your attention after the Nutting patent application passed out of your jurisdiction?

A Maybe.

MR. WELSH: I thought the question was during his --

MR. LYNCH: Yes. He said maybe to both.

Q Is that article located in the shoes which you maintain in your search area?

A I believe so.

Q Do you know what sub-class it exists in?

A Yes, but I am not sure if it is there.

Q Where would it be, if it were there?

A Technically, it should be in Class 273 - 121A.

MR. LYNCH: I would like to have the reporter mark as Hum Deposition Exhibit No. 5 copy of an article appearing in Electronics, March 1, 1973 at Pages 63 and 64, entitled Microcomputers muscle in.

(The document referred to was marked Hum Dep. Exhibit No. 5 for identification.)

Q On Page 64 of Hum Deposition No. 5, concluding

1 sentence, ascribed to Mr. Kroeger the following: "My
2 example of a mass market is pinball machines. I think
3 I mean that literally but most people think I am
4 exaggerating."

5 I ask you, Mr. Hum, if you were aware of
6 Hum Deposition Exhibit 5 during the examination of the
7 Nutting patent application and while it was within
8 your jurisdiction?

9 A I don't think I was aware of that reference.

10 Q Mr. Hum, in the office action of February
11 26, 1976, it says on Page 4, "If applicant includes
12 in Claims 1 and 12 limitations directed to a pinball
13 machine and associated elements, eg. player operated
14 flipper means, ball means and projector means, et
15 cetera correlated to claimed structure, and if the
16 indefinite portions are clarified, then claims would
17 appear allowable.

18 At the time you issued that action, is it
19 fair to say, Mr. Hum, that you were not aware of Hum
20 Deposition Exhibits 2, 3, 4, and 5?

21 MR. TARRING: Hasn't he already testified
22 in effect to that?

23 A Yes.

Q Now in the first office action, Mr. Hum, you rejected all of the claims of the application, isn't that correct?

MR. TARRING: Here we are going into interpreting the file.

MR. LYNCH: Mr. Tarring, just to make a readable file, it is easy for you to understand to set a precedent for the next question. I am really not belaboring the point.

MR. TARRING: I don't like to point out there are cases where it is proper to ask an examiner on interpreting the file, we have a job to do. We started at 9:30 and it's after 4:00 already.

MR. LYNCH: I understand.

Q Mr. Hum, referring to the office action of February 26, 1976, is it not correct that you rejected all the claims of the Nutting patent application?

A Yes.

Q Now at the time were any of the claims limited to a pinball game?

MR. WELSH: I object to the question as calling for an interpretation of the claims, and it is surely an improper question.

MR. TARRING: I agree. Advise you not to

1 answer that one.

115

2 MR. GOLDENBERG: I seriously doubt the plain-
3 tiff will be taking that position at time of trial.

4 MR. LYNCH: Your position, Mr. Welsh, is that
5 Mr. Hum cannot testify as to whether any of these
6 claims are limited to pinball, is that your position?

7 MR. WELSH: I am objecting to the question
8 calling for Mr. Hum to interpret the claims, calls
9 for his mental process.

10 MR. LYNCH: I would like to point out there
11 are cases where it is proper to ask an examiner on
12 what he relied on issuing an office action, and what
13 facts he relied on.

14 MR. TARRING: Cases in which the Patent and
15 Trademark office was not a party.

16 MR. LYNCH: I understand that. I am pointing
17 out there is a court that says that is appropriate.
18 I gather you don't think it is appropriate.

19 MR. TARRING: I think that in certain items,
20 if I am recalling the same case you are referring to,
21 I think we do disagree with the breakdown as far as
22 what due process is.

23 Q Mr. Hum, I would like to refer you to the

1 office action of November 18, 1976, and in particular,
2 to the first paragraph on Page 2 of that office action,
3 where it is indicated the notice of allowance or the
4 indication of allowance was being withdrawn in view of
5 references recently brought to the attention of the
6 examiner.

7 How did the references that you cited, and on
8 which this action is based, come to your attention?

9 A I had received it in the mail, I presume.

10 Which reference are you referring to?

11 Q It says in view of references recently brought
12 to the attention of the examiner. I was wondering
13 what the circumstances were under which these
14 references were brought to your attention?

15 MR. TARRING: Can you identify the references?

16 Q (Continuing) What are the references to which
17 you refer in the first paragraph of the office action
18 of November 18, 1976?

19 A I think that is a reference to Popular Elec-
20 tronics.

21 Q I believe that is in your 892, only a single
22 new reference is noted.

23 How did that reference come to your attention?

A I received it in the mail. I am so far behind in my reading, it is just stacked up. Popular Electronics is a magazine I subscribe to.

Q And you were behind from January, 1975 to November of 1976?

A Yes.

Q What caused you to select that Popular Electronics article as being relevant?

MR. WELSH: Object to the question as calling for analysis of mental process of the examiner.

MR. TARRING: I advise him not to answer that one. I agree it calls for analysis of mental process.

Q I would like to refer you to Page 6 of the response to that office action, that is the amendment received or dated February 22, 1977, and ask you if you recall what the applicant was setting forth at that time as being the fundamental essence of the invention of the application?

MR. TARRING: Are you asking him what the applicant was thinking?

MR. LYNCH: No. I am asking what he was setting forth.

Q Let me ask you this, Mr. Hum: Do you recall

1 entering the ^{prosecution} ~~prosecution~~ of this case the applicant's
2 intention about what the essence of the invention was?
3

4 MR. WELSH: I object to that, also, as in-
5 quiring into his mental processes, analyses, or con-
6 clusions, in acting upon the application.

7 MR. TARRING: I don't care if he doesn't
8 have to go to the file to do it. If he recalls, he
9 recalls.

10 A I don't recall.

11 Q Now with respect to the operation of seven
12 segment displays, Mr. Hum, were you familiar during
13 the time that you examined the Nutting patent appli-
14 cation the manner in which seven segment displays
15 were operated?

16 MR. WELSH: Where?

17 Q In any context. Were you aware how they
18 operated; were you aware of the operation of seven
19 segment numerical displays?

20 MR. WELSH: Object to the question as lacking
21 a foundation.

22 MR. LYNCH: Mr. Tarring, you are looking pained.
23 If you want me to drag out a hundred and fifty refer-
ences on seven segment displays and establish whether

1 or not the examiner was aware of each one, and then I
2 still haven't established this one fact. I want to
3 know whether or not he was aware of the manner of
4 operation of seven segment numerical displays.

5 MR. TARRING: With respect to what?

6 MR. LYNCH: With respect to any manner in
7 which they are applicable.

8 Q Let me ask this question: Were you aware of
9 the fact that in the prior art to the Nutting patent
10 application that alphanumeric seven segment displays were
11 operated by multiplex techniques?

12 MR. WELSH: I object to the question as
13 assuming a fact which has not been proven.

14 Q Were you familiar whether or not alphanumeric
15 seven segment displays in the prior art had been
16 operated using multiflex techniques?

17 A May I consult with counsel?

18 Q Yes.

19 MR. WELSH: I would like to object to the
20 question as to what is meant by prior art, with
21 respect to what?

22 MR. LYNCH: With respect to the Nutting patent.

23 A Would you repeat the question?

1 Q Will you tell me, Mr. Hum, whether you were
2 aware that in the prior art of the Nutting patent
3 application seven segment alphanumeric displays were
4 operated using multiplex techniques?

5 MR. WELSH: I object to the question on the
6 grounds stated to the one next previous to the last
7 question.

8 MR. TARRING: I don't like the use of prior
9 art. You have a factual situation that exists and if
10 you want to ask him if he was aware of whatever it is.

11 Q Were you aware of published references dated
12 prior to the filing date of the Nutting patent appli-
13 cation, which talked about the use of multiplex
14 techniques to seven segment alphanumeric displays?

15 MR. WELSH: Object to this question. It
16 assumes a fact.

17 A I was not aware of any specific prior art
18 reference.

19 Q Were you aware generally that such techniques
20 had been used to operate alphanumeric seven segment
21 displays?

22 A I would have been reasonably certain that
23 such did occur.

1 Q Let's talk about seven segment numeric
2 displays, is your answer the same?

3 A What was the question?

4 Q I was asking you whether you were aware
5 generally seven segment numeric displays were operated
6 using multiplex techniques in the prior art to the
7 Nutting application, let's say?

8 Were you aware generally that techniques
9 using multiplex were used to operate seven segment
10 numeric displays, prior to the Nutting patent
11 application?

12 A I am reasonably certain that I was aware of
13 such techniques.

14 Q I show you what I will ask the reporter to
15 mark as Hum Deposition Exhibit 6, Parallel Processing
16 System (PPS), Rockwell International, specifically
17 Page 6 of that document.

18 (The document referred to was
19 marked Hum Dep. Exhibit No. 6
20 for identification.)

21 I ask you, Mr. Hum, if you were aware of that
22 application at the time you examined the Nutting
23 patent application?

1 A I was not aware of this publication.

2 Q In particular, Mr. Hum, I direct you to Page
3 6 of Hum Deposition No. 6, and ask if you, at the
4 time you examined the Nutting patent application, you
5 were familiar with the drawings of computer systems
6 such as or that type of schematic drawing as described
7 there in the application notes?

8 MR. WELSH: I object to the question. He
9 stated that he was not familiar with it at that time,
10 and the question lacks foundation.

11 MR. LYNCH: I will ask the reporter to mark
12 this next document:

13 (The document referred to was
14 marked Hum Dep. Exhibit No. 7
15 for identification.)

16 Q I will ask you, Mr. Hum, whether you were
17 aware of the MCS-4 Micro Computer Set, Users Manual,
18 dated March, 1972, marked Hum Deposition Exhibit 7,
19 at the time that you were examining the Nutting patent
20 application?

21 A I was not aware of this at the time of the
22 Nutting application.

23 MR. LYNCH: There's been a lot of discussion

1 here, Mr. Tarring, about another patent application.
2 I have a copy of another patent application. It is
3 still an application in the office, which I obtained,
4 I might add, from a foreign source who submitted it.

5 Is the position of the Patent Office that I
6 may not examine the examiner about the facts set forth
7 in this? I have it in my possession.

8 MR. WELSH: I will object.

9 MR. TARRING: You may have it in your possession
10 but 35 USC 122 is very specific against the Patent and
11 Trademark Office.

12 MR. LYNCH: There are certain facts which
13 can be noted in here which could be relevant to the
14 present application, and I am wondering --

15 MR. WELSH: That is what we are objecting to,
16 any pending application.

17 MR. LYNCH: It seems to me there are relevant
18 aspects to inquire into here that certain aspects of
19 this application which are relevant to the Nutting
20 patent here, but your position is that I may not ask
21 the examiner about such knowledge?

22 MR. TARRING: No.

23 MR. WELSH: I object to any question calling,

1 for any information to be given by the Patent Office
2 with respect to this, even as to whether Mr. Hum has
3 any knowledge of it or not.

4 MR. LYNCH: I've got the document, and I
5 came into its possession properly. My position is in-
6 sofar as this document is concerned, it contains facts.
7 It came from a foreign patent office. It was sub-
8 mitted as a prior art document where it is available.

9 MR. TARRING: If it contains facts, I don't
10 see why it is necessary to ask the examiner about
11 facts in the document.

12 MR. WELSH: Whether this examiner has any
13 information or any knowledge of this application is
14 improper information to be given out by the Patent
15 Office.

16 MR. TARRING: Who is the application from, who
17 is the attorney of record?

18 MR. LYNCH: It's a Bally application.

19 MR. WELSH: I don't think you will find that
20 to be true.

21 MR. LYNCH: Then it's another attorney.

22 Q I will show you, Mr. Hum, Pages 81 and 95
23 of an article from Electronics magazine, July 11, 1974,

1 in particular the last paragraph on Page 95, "The
2 microprocessor monitors the placement of the ball
3 when it is sent down the lane by a player (one to four
4 can play at any one time), keeps tabs on the ^{pins} ~~pines~~,
5 and metes out free games and credits.

6 I would like to ask Mr. Hum if he was aware of
7 that article during the pendency of the Nutting patent
8 application?

9 A No, I was not aware of this.

10 Q Have you ever been made aware of that document
11 under any circumstances?

12 A I don't remember.

13 (The document referred to was
14 marked Hum Deposition Exhibit
15 No. 8 for identification.)

16 MR. WELSH: I think the record ought to show
17 it is not a complete article.

18 MR. LYNCH: No, it is not a complete article.
19 I marked that page.

20 MR. LYNCH: I don't have any further questions.

21 EXAMINATION IN BEHALF OF THE PLAINTIFF

22 BY MR. WELSH:

23 I ask Mr. Hum, when you were asked about this

1 Hum Deposition Exhibit 7, you stated that you were not
2 aware of it at the time of examining the Nutting patent
3 application resulting in the patent that ensued.

4 During that same time, were you aware of any
5 other Intel manuals?

6 A Not during the prosecution of the Nutting
7 application, the best I can recall.

8 Q Do you have any such manual in your possession?

9 A I do now.

10 Q Do you recall discussing such a manual in
11 your possession with Mr. Katz?

12 MR. LYNCH: Objection, leading.

13 A With Mr. Katz?

14 Q Yes.

15 A I believe we discussed this manual.

16 Q The manual that you have in your possession?

17 A Yes. I am not certain it is the MCS-4.

18 Q Did you discuss any Intel manual?

19 A Yes.

20 Q What Intel manual do you have in your
21 possession?

22 A I believe it is this one, but I am not certain.
23 I haven't looked at it.

1 Q But you do remember discussing with Mr. Katz
2 your manual during the interview?

3 A Can you be more specific to the interview?

4 MR. LYNCH: I object to the question as being
5 grossly leading.

6 Q Do you recall discussing an Intel manual with
7 Mr. Katz at the last interview you had with him in
8 connection with this application?

9 MR. LYNCH: I would like to comment for the
10 record that such leading of the witness under these
11 circumstances is unfair. The witness has already
12 testified that he didn't remember on this issue.

13 MR. WELSH: I don't think that is true.

14 MR. TARRING: I really don't want to get
15 into such questions. I think they would be more
16 appropriate for the court.

17 Q Are you familiar, Mr. Hum, with the proceeding
18 in the Patent Office held in February called the
19 National Inventors Day Exhibition?

20 A Yes.

21 Q Did you have anything to do with that
22 exhibition held on February 10th and 11th?

23 A Yes.

1 Q What is National Inventors Day Exhibition,
2 to your knowledge?

3 A It is an exhibition to display the work of
4 inventors.

5 MR. LYNCH: I would like to object to this
6 line of questioning as clearly exceeding the scope of
7 direct.

8 MR. WELSH: If you have any objection, I will
9 make the witness my own witness for the purpose of this.

10 MR. GOLDENBERG: You weren't invited to do
11 that, sir. You were invited to attend and cross examine.
12 You should get your own subpoena and set up your own
13 deposition.

14 Q What did you have to do with the National
15 Inventors Day Exhibition?

16 MR. LYNCH: This is going into a mental
17 process, and I will advise you right now --

18 MR. WELSH: I am asking for facts, what he did.

19 THE WITNESS: May I confer with counsel?

20 MR. TARRING: I am hard pressed to see the
21 relevance of this since it occurred after the patent
22 issued.

23 MR. GOLDENBERG: I make that objection. I do

not believe it is relevant or reasonably calculated to lead to discovery of admissible evidence.

MR. WELSH: With your objection on the record, this is an act that I believe the witness participated in with respect to the patent ensued, and while not related to the application specifically, I believe it is a proper subject matter for us to inquire into.

If it is necessary, we will come back with a subpoena, but I am trying to avoid that. I only have a few questions basically to have the witness identify this document that I have, copy of a document that I believe was prepared by him, and that is the extent that I wish to go.

MR. LYNCH: This has to do with a reflection of this allegedly on the worth of the invention, because it was or was not included in this exhibit. If this is admissible and any testimony of this examiner comes in on the issue of whether the invention is "worth-while, or good, or excellent, or anything" because it was included in this exhibition, the Patent Office has opened the door for me to examine this gentleman about his entire thought process about the Nutting patent.

MR. GOLDENBERG: I join in that.

1 MR. LYNCH: It is absolutely a mental process
2 situation, otherwise it is gross hearsay, because it
3 represents an unsworn statement of the witness including
4 this thing in an exhibition as the reflection of the
5 worth of the technology involved. It is hearsay.

6 MR. WELSH: If you will stipulate that the
7 Fireball pinball machine at the National Inventors
8 Day Exhibition amounted to a recognition of the high
9 level of invention of that apparatus, then it won't
10 be necessary to continue.

11 MR. LYNCH: Could you rephrase that; maybe
12 high level is the thing that is giving me trouble. If
13 the examiner is permitted to testify about the inclusion
14 of this as germane to the level of invention involved,
15 you have opened the door, Mr. Tarring.

16 MR. WELSH: I don't expect to ask any ques-
17 tions about his reasons for doing this. I am only
18 seeking to inquire that he filled out this application
19 for exhibition space.

20 MR. GOLDENBERG: I tell you this, sir, if
21 he does that, I have the right to cross examine on
22 this document and all aspects of this matter.

23 MR. LYNCH: This is after the patent is

1 issued, and not an ^{examination} ~~examination~~ function, and we have
2 opened the door to his mental processes with respect
3 to the entire matter.

4 MR. TARRING: I don't agree with that at all.
5 I haven't seen the stupid thing.

6 MR. LYNCH: The entire idea that this examiner
7 is permitted to testify at all about an application
8 for exhibit space that is prepared by him after the
9 patent issued as reflecting on the worth of that
10 patent, you are permitting a patent office employee
11 to testify about facts after a patent is issued, and
12 the only context that could be relevant has to reflect
13 to the alleged worth of that patent, or that application.

14 MR. WELSH: Where does it say anything about
15 the alleged worth of the exhibit?

16 MR. GOLDENBERG: That exhibit is offered to
17 the public for some public relations purpose on the
18 part of the Patent Office, and there is perhaps some
19 kind of suggestion that these things are being shown
20 to the public as being meritorious things and meritorious
21 patents.

22 MR. WELSH: That is not my point at all.

23 MR. LYNCH: What is your point. You want to

1 stipulate this was at this exhibit, I will stipulate
2 it was there, the Fireball pinball machine was there.
3 You want to stipulate to that?

4 MR. WELSH: Sure, I would.

5 MR. LYNCH: I will withdraw the stipulation -
6 if you want to prove it was there, that is fine, but
7 if you want to prove anything about the patent examiner
8 making a request or filling out an application for
9 exhibits or passed on the subject matter of a device
10 which is allegedly covered by 40932, which is the
11 patent in suit. If he knew that device was in
12 accordance with that patent, there is a whole raft
13 of things we are going to have to go into, and it is
14 not appropriate.

15 MR. GOLDENBERG: Do you recognize, Mr. Tarring,
16 our right, if it comes, to inquire about this matter?

17 MR. TARRING: Sure.

18 MR. LYNCH: May I see the statement you read
19 this morning? Patent examiners are forbidden to express
20 opinions in testimony or otherwise.

21 MR. TARRING: I haven't heard anything yet
22 as to his expressing an opinion.

23 MR. LYNCH: This is a document directed to

1 the patent after it issued. I don't believe he can
2 comment on it after it issued. I believe it passed out
3 of his jurisdiction, and he is constrained not to
4 comment on that patent after it is issued.

5 MR. WELSH: You are construing an action,
6 and that is merely argument.

7 MR. GOLDENBERG: We will have to ask the
8 examiner why this one was selected when there are a
9 number of patents issued during the course of a year.
10 There are all kinds of questions, and there is no end
11 to it. I am willing to ask the questions. I should
12 be delighted, if the door is opened to Mr. Hum's
13 reasoning processes, that is the effect of this, Mr.
14 Tarring.

15 MR. WELSH: I don't think that is the effect
16 of it at all.

17 MR. TARRING: I don't see where that is the
18 effect at all. I don't see where there is an opinion
19 expressed in this. It seems to be a form stating
20 things.

21 MR. GOLDENBERG: It is far more than that.

22 MR. TARRING: I would rather you all take it
23 up with the judge.

1 MR. WELSH: It would save a trip back if we
2 could have this document identified by the witness as
3 having been prepared by him.

4 MR. GOLDENBERG: I cannot consent to his
5 identifying that document unless I am given an oppor-
6 tunity to examine the witness about it, and all its
7 ramifications.

8 MR. TARRING: I don't agree with that. The
9 fact whether he prepared it, it's there.

10 MR. WELSH: Questions about his opinion may
11 be improper. Do you think

12 MR. GOLDENBERG: Wouldn't it be better if we
13 accept your suggestion and submit the matter to our
14 judge.

15 MR. LYNCH: I am perfectly willing to do that.

16 MR. WELSH: I don't see that it is a proper
17 inquiry for our court. You're alleging it involved
18 some improper conduct of the Patent Office.

19 MR. GOLDENBERG: There is no suggestion of
20 improper conduct. Mr. Lynch's statements were very clear.

21 MR. LYNCH: I am saying for the examiner to
22 have done it is one thing. For it to be submitted in
23 this litigation is improper. What it does, it reflects

1 upon the fact that this examiner selected this patent
2 to go into the exhibit space. If that is permitted to
3 be addressed and established as a fact, then we have
4 to go into the whys and wherefores, otherwise the
5 inference is going to be made that examiner Hum, out
6 of all the patents issued, selected this one as being
7 meritorious enough to be in National Inventors Day,
8 in the opinion of examiner Hum as reflected by that
9 act.

10 MR. TARRING: I don't see any opinion stated.

11 MR. GOLDENBERG: What do you think Mr. Welsh
12 wants this for. There isn't any doubt in my mind that
13 he is going to go, at the time of trial, if there is
14 a trial in this case, and offer this document as a
15 certificate of merit for this invention, and refer to
16 this act as a recognition by the Patent Office. Is
17 there any doubt in your mind on that?

18 MR. LYNCH: Otherwise, it would have no
19 relevance.

20 Let's have Mr. Welsh state the relevance
21 to the issues here.

22 MR. WELSH: I don't feel compelled, at this
23 time, to state any relevance.

1 MR. LYNCH: I understand that.

2 MR. WELSH: It's a fact as to whether the
3 patent was selected for the space at the National
4 Inventors Day Exhibition, and what inferences may be
5 drawn by that are merely argumentative. This is
6 simply whether or not space was requested and granted,
7 and actually filled with a particular machine. Those
8 are simply facts.

9 MR. LYNCH: By the examiner is what he wants
10 to establish, the examiner involved.

11 MR. TARRING: In view of the fact that you
12 are objecting because it goes beyond the scope of
13 direct, and I think it is clear that it does, I would
14 just as soon duck the question and let the court de-
15 cide what to do. I don't need any more problems.

16 MR. WELSH: Do I understand correctly then
17 that you will not permit the witness to answer questions
18 regarding the National Inventors Day Exhibition?

19 MR. TARRING: At this time. I would rather
20 you get it straightened out with the court as to where
21 you stand on it. I am firmly convinced, insofar as
22 this matter right here is concerned, it has nothing
23 to do with the examination or the scope of the

1 protective order. If it is going to go back to the
2 application itself and how the examiner considered
3 matters there, I think that is entirely inappropriate,
4 and certainly doesn't open the door to that extent.

5 MR. WELSH: I have no other questions.

6 FURTHER EXAMINATION ON BEHALF OF WILLIAMS

7 BY MR. GOLDENBERG:

8 Q Do you recall any discussions with Mr. Katz
9 about Intel publications or manuals?

10 A Not in the course of the Nutting application,
11 as best I can recall.

12 Q Was there a discussion at some later time
13 with Mr. Katz after the Nutting patent issued?

14 A With respect to your question, at a later time

15 Q Was it in connection with the application to
16 reissue the Nutting-Fredericksen patent? These
17 are open proceedings, that is my question.

18 MR. WELSH: There is no procedure in the
19 Patent Office for examination of an examiner under
20 oath in reissue proceedings. You are improperly taking
21 advantage of the suit pendency in the court on the
22 original patent to make inquiry into matters where you
23 would not otherwise have the right to make such

1 inquiry. I object to that question.

2 MR. GOLDENBERG: Can we have an answer, Mr.
3 Tarring?

4 MR. TARRING: I think I know the answer to
5 the question, and that is why I think to a degree
6 it is inappropriate. I think I know the answer but I
7 will ask Mr. Hum to verify it.

8 I am going to let him answer it.

9 A Would you repeat the question, please?

10 Q Was the discussion with Mr. Katz about the
11 Intel manual in connection with the application to
12 reissue the Nutting-Fredericksen patent?

13 A I really don't know, but I think I would have
14 to -- May I explain?

15 MR. TARRING: Yes.

16 A I am going to invoke 35 USC 122.

17 MR. LYNCH: That's the explanation? It
18 didn't sound like any explanation I ever heard.

19 MR. WELSH: I think it is very acceptable.

20 Q Do you have more than one Intel publication
21 in your possession, in your files, sir?

22 A I don't know.

23 Q You had something specific in mind when you

1 answered Mr. Welsh's question; what did you have in
2 mind when you gave him an affirmative answer?

3 A I think I have that particular manual in my
4 office.

5 Q Do you recall when it came into your possession?

6 A Very recently.

7 Q How did it get in your possession?

8 A I have to invoke 35 USC 122.

9 Q Did Mr. Katz give it to you?

10 MR. WELSH: Objection. He already said he
11 was invoking 35 USC 122. I think it is improper to
12 ask him anything further about it.

13 MR. LYNCH: The communications are right in
14 the area where there is an area of concern.

15 MR. TARRING: Our examiners handle applications
16 in a particular area, and they are going to get those
17 applications, and there is nothing unusual about the
18 fact that they might have one, two, or many applications
19 in a particular area. I am not sure a communication
20 going on between them; they are learning of prior art
21 on a continuous basis should surprise anyone really.

22 Q Since the patent issued, have you had any
23 discussed with Mr. Katz or any other attorney

1 representing Bally in connection with the Nutting
2 patent?

3 A Since it issued?

4 Q Yes.

5 A Yes.

6 Q With whom, sir?

7 A Mr. Katz, I believe.

8 Q How many such conversations were there?

9 A I don't remember the number.

10 Q More than one?

11 A Yes, I would say so.

12 Q Have any of those conversations occurred
13 since the application was filed to reissue the patent?

14 A Before the reissue was filed?

15 Q Since the reissue was filed?

16 A I don't think so, but I can't be certain.

17 (Whereupon, at 5:40 p.m., the taking of the
18 deposition was concluded.)
19
20
21
22
23

I have read the foregoing 140 pages, which contain a correct transcript of the answers made by me to the questions therein recorded.

Lance J. Horn

Signed before me this 5th
day of Sept. 1979.

Marian E. Ford
Notary

My Commission Expires January 13, 1981

To whom it may concern:

Errata sheet for
Transcript of Deposition of
Vance Y. Hum
on July 24, 1979

In addition to the errors corrected by interlineation and my initials in the original transcript, I want to point out that one answer, while correctly transcribed, indicates a possible inaccuracy. I discovered the possible inaccuracy on checking documents in my office subsequent to the deposition.

Specifically, at page 126, line 22, I indicated a belief that I had the Intel Users Manual for MCS-4 Micro Computer Set, dated March, 1972, a copy of which is designated Hum Dep. Exhibit No. 7, in my possession. In fact, the Intel User Manuals I have in my possession are the MCS-80 and the 8080 models. I do not have the Users Guide for the MCS-4 in my possession.

Vance Y. Hum
Vance Y. Hum
Primary Examiner
Sept. 5, 1979